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May 14, 2010

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Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
Ex parte Stern
Appeal No. _____**

Serial No.: 09/558,329
Filed: April 25, 2000
Group Art Unit: 1711
Examiner: Cheryl Juska
Applicant: Randolph A. Stern and Michael N. Byles
Title: Stitch Bonded Fabric and Fluid-Retaining Fabric Made Therewith
Attorney Docket: STAN-09RE
Conf. No.: 9722

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

May 14, 2010

Dear Sir or Madam:

APPEAL BRIEF

This Appeal Brief is submitted in response to the Final Official Action mailed on April 14, 2010.

Table of Contents

I.	Real Party In Interest	1
II.	Related Appeals and Interferences	2
III.	Status of Claims.....	5
IV.	Status of Amendments	6
V.	Summary of Claimed Subject Matter.....	7
VI.	Ground(s) of Rejection to Be Reviewed on Appeal	13
VII.	Argument.....	15
	A. Examiner is Unlawfully Ignoring the Words of the Claim	18
	B. Examiner Refuses to Consider the Real Meaning of "Felt"	25
	C. The Cited Art Neither Discloses nor Renders Obvious the Claimed Invention	27
	1. Overview.....	27
	2. The Cited Art Does Not Anticipate the Claimed Inventions	28
	a. Claim improperly rejected under 35 U.S.C. § 102(b) as anticipated by Sternlieb ...	29
	b. Claims improperly rejected under 35 U.S.C. § 102(b) as anticipated by Lefkowitz	30
	c. Claims improperly rejected under 35 U.S.C. § 102(b) as anticipated by Ott	30
	d. Claims improperly rejected under 35 U.S.C. § 102(b) as anticipated by Gillies	31
	3. The Cited Art Does Not Render Obvious the Claimed Inventions.....	33
	a. Claims improperly rejected under 35 U.S.C. § 103(a) over Gillies in view of Ott ...	33
	b. Claims improperly rejected under 35 U.S.C. § 103(a) over Kyles in view of Gillies, Ott and/or Sternlieb	33
	Conclusion	35
VIII.	Claims Appendix.....	37
IX.	Evidence Appendix	53
X.	Related Proceedings Appendix	54

I. Real Party in Interest

The real party in interest is Standard Textile Co., Inc., a corporation of the State of Alabama, which is the Assignee of the present invention.

II. Related Appeals and Interferences

With the possible exception of the two prior occasions in which Appellants have brought this application before the Board, there are no related appeals or interferences known to the Appellant or the Appellants' legal representative that will directly affect, or be directly affected by, or have a bearing on the decision of the Board in the present appeal.

For sake of completeness, Appellants advise the Board of the subject matter of the two previous occasions in which Appellants have brought or attempted to bring this application before this Board. On the first occasion (Appeal No. 2005-0019), this Board reversed the Section 112 rejections (applicable only to claims 30-87 added in the reissue) but, focusing then on the term "yarn face" in all of the claims, affirmed the Section 103 rejections of all claims and the Section 102 rejections applicable to many of the claims due to the alleged breadth of that term. *See* this Board's Decision on Appeal mailed January 19, 2005, a copy of which is attached in the Related Proceedings Appendix. Subsequent to the Board's Decision, the Examiner reopened prosecution and Appellants amended the claims to more particularly specified aspects of the "yarn face" in relation to the "felt" directly in the claims to overcome the rejections. These amendments were subject to final rejection in the Final Official Action mailed on May 2, 2006.

On the second occasion, Appellants appealed the aforementioned May 2, 2006 Final Official Action. However, this Board did not consider the merits of the appeal and instead returned the undocketed appeal to the Examiner for a) correction of all amended and new claims in compliance with 37 C.F.R. § 1.173; b) correction of the Claim Appendix in compliance with 37 C.F.R. § 1.173; c) submission of a proper supplemental reissue declaration to overcome a

rejection of all claims under Section 251; and d) for such other action as may be appropriate. *See* this Board's Order Returning Undocketed Appeal mailed March 17, 2009, a copy of which is attached in the Related Proceedings Appendix. Nearly six months later, on September 10, 2009, the Examiner issued an Official Action based on the Board's Order requiring submission of claims in compliance with 37 C.F.R. § 1.173 and rejecting all of the claims under Section 251. The Official Action also maintained the rejections based on Sections 102 and 103 from the Final Official Action mailed on May 2, 2006. In Applicants' Response dated December 17, 2009, Applicants amended the claims in compliance with 37 C.F.R. § 1.173 to show deleted matter in brackets and to state that the claims were once amended or twice amended. Applicants made no substantive amendments to the claims. Applicants also submitted a properly executed supplemental reissue declaration. The Examiner issued a Final Official Action on April 14, 2010 therein a) entering the claim amendments from Applicant's Response, b) entering the supplemental reissue declaration and withdrawing the rejections under Section 251 in view thereof, c) objecting to the presence of the term "pending" in the status identifiers attached to each claim, and d) maintaining the rejections under Sections 102 and 103 from the September 10, 2009 Official Action. In response to the Examiner's objection, Appellants have removed the term "pending" from the status identifiers for each claim in the Claims Appendix for the present appeal.

Having corrected the formalities identified by the Board, Appellants now desire to reinstate the previously undocketed appeal. As such, with the exception of a) the description of the occasions in which the Appellants have brought this application before this Board as explained hereinabove, b) the reformatted claims in the Claims Appendix, and c) the reformatting of some

section headings, the substance of the present Appeal Brief is identical to the brief in the undocketed appeal returned by this Board on March 17, 2009. Since this Board returned the previous appeal undocketed, it has not yet considered the merits of the claim amendments particularly specifying aspects of the "yarn face" in relation to the "felt." As such, these issues are now ripe for the Board's consideration.

III. Status of Claims

Claims 1-87 are rejected. Claims 1-87 are currently pending and are subject to this appeal.

A copy of these claims is included herein in the Claims Appendix.

IV. Status of Amendments

No amendments were made to the claims after the Final Office Action on April 14, 2010.

V. Summary of Claimed Subject Matter

Claims 1, 12, 23, 30, 39, 51, 58, 65, 70, and 80 are independent claims.

Independent Claim 1

Appellant's independent claim 1 is directed to a stitch bonded facing fabric (10). *See* col. 2 lines 31-65 and Figures 1, 2, and 5 of Appellant's specification. The stitch bonded facing fabric (10) includes a first layer of hydrophobic felt (14) and a second layer of hydrophilic felt (16) adjacent to the first layer (14) so as to define a felt web (12) having an upper surface (20) defined by an upper side of the first layer and a lower surface (22) defined by a lower side of the second layer. A plurality of stitch bonding yarns (18) repeatedly extends through the felt web (12). The yarn segments (18', 18'') extend across both the upper (20) and lower surfaces (22) of the felt web (12) such that the yarn segments (18') extending across the felt web (12) upper surface (20) cooperate to form a top yarn face (24) above the felt web (12) upper surface (20) and the yarn segments (18'') extending across the felt web (12) lower surface (22) cooperate to form a bottom yarn face (26) below the felt web (12) lower surface (22). Each yarn face (24, 26) is effectively continuous such that the corresponding web surface (20, 22) is not generally exposed at the associated yarn face (24, 26). *See* col. 2 lines 59-63.

Independent Claim 12

Appellant's independent claim 12 is directed to a stitch bonded facing fabric (10). *See* col. 2 lines 31-65 and Figures 1, 2, and 5 of Appellant's specification. The stitch bonded fabric (10) includes a felt web (12) having a hydrophobic upper aspect (14) extending from an upper surface (20) of the web (12) and a hydrophilic lower aspect (16) extending from a lower surface (22) of the web (12). A plurality of stitch bonding yarns (18) repeatedly extends through the felt web (12) with yarn

segments (18) extending across both the upper (20) and lower (20) surfaces of the felt web (12). The yarn segments (18') extending across the felt web (12) upper surface (22) cooperate to form a top yarn face (24) above the felt web (12) upper surface (20). The yarn segments (18'') extending across the felt web (12) lower surface (22) cooperate to form a bottom yarn face (26) below the felt web (12) lower surface (22). Each yarn face (24, 26) is effectively continuous such that the corresponding web surface (20, 22) is not generally exposed at the associated yarn face (24, 26). *See* col. 2 lines 59-63.

Independent Claim 23

Appellant's independent claim 23 is directed to a fluid retaining fabric. *See* col. 3 lines 20-35 and Figures 6 and 7 of Appellant's specification. The fluid retaining fabric includes a stitch bonded facing fabric (10) having a first layer of hydrophobic felt (14), a second layer of hydrophilic felt (16) being adjacent to the first layer so as to define a felt web (12) having an upper surface (20) defined by an upper side of the first layer (14) and a lower surface (22) defined by a lower side of the second layer (16). A plurality of stitch bonding yarns (18) repeatedly extend through the felt web (12) with yarn segments (18', 18'') extending across both the upper (20) and lower (22) surfaces of the felt web (12). The yarn segments (18') extending across the felt web (12) upper surface (20) cooperate to form a top yarn face (24) above the felt web (12) upper surface (20). The yarn segments (18'') extending across the felt web (12) lower surface (22) cooperate to form a bottom yarn face (26) below the felt web (12) lower surface (22). Each yarn face (24, 26) is effectively continuous such that the corresponding web surface (20, 22) is not generally exposed at the associated yarn face (24, 26). *See* col. 2 lines 59-63. A barrier layer (40) is attached to the bottom

yarn face (26).

Independent Claim 30

Appellant's independent claim 30 is directed to a stitch bonded facing fabric (10). *See* col. 2 lines 31-65 and Figures 1, 2, and 5 of Appellant's specification. The stitch bonded facing fabric (10) includes a felt web (12) having an upper surface (20) and a lower surface (22). The stitch bonded fabric (10) has a plurality of stitch bonding yarns (18) repeatedly extending through the felt web (12) with yarn segments (18', 18'') extending across both the upper (20) and lower (22) surfaces of the felt web (12). The yarn segments (18') extending across the felt web (12) upper surface (20) cooperate to form a top yarn face (24) above the felt web (12) upper surface (20). The yarn segments (18'') extending across the felt web (12) lower surface (22) cooperate to form a bottom yarn face (26) below the felt web (12) lower surface (22). Each yarn face (24, 26) is effectively continuous such that the corresponding web surface (20, 22) is not generally exposed at the associated yarn face (24, 26). *See* col. 2 lines 59-63.

Independent Claim 39

Appellant's independent claim 39 is directed to an incontinent pad. *See* col. 3 lines 23-26 and Figures 6 and 7 of Appellant's specification. The incontinent pad includes a stitch bonded facing fabric (10) having a felt web (12) having an upper surface (20) and a lower surface (22). A plurality of stitch bonding yarns (18) repeatedly extend through the felt web with yarn segments (18', 18'') extending across both the upper (20) and lower (22) surfaces of the felt web (12). The yarn segments (18') extending across the felt web (12) upper surface (20) cooperate to form a top yarn face (24) above the felt web (12) upper surface (20). The yarn segments (18'') extending across the

felt web (12) lower surface (22) cooperate to form a bottom yarn face (26) below the felt web (12) lower surface (22). Each yarn face (24, 26) is effectively continuous such that the corresponding web surface (20, 22) is not generally exposed at the associated yarn face (24, 26). *See* col. 2 lines 59-63. A barrier layer (40) is joined to the facing fabric (10) so as to confront the bottom yarn face (26) of the facing fabric (10).

Independent Claim 51

Appellant's independent claim 51 is directed to a fluid retaining fabric. *See* col. 3 lines 20-35. The fluid retaining fabric includes a felt web (12) having an upper surface (20) and a lower surface (22). The felt web (12) is adapted to retain fluid. *See* col. 3 lines 20-23. A plurality of stitch bonding yarns (18) repeatedly extend through the felt web (12) with yarn segments (18', 18'') extending across both the upper (20) and lower (22) surfaces of the felt web (12). The yarn segments (18') extending across the felt web (12) upper surface (20) cooperate to form a top yarn face (24) above the felt web (12) upper surface (20). The yarn segments (18'') extending across the felt web (12) lower surface (22) cooperate to form a bottom yarn face (26) below the felt web (12) lower surface (22). The stitch bonding yarns (18) are hydrophobic to assist in wicking fluid into the felt web (12). *See* col. 3 lines 8-10. Each yarn face (24, 26) is effectively continuous such that the corresponding web surface (20, 22) is not generally exposed at the associated yarn face (24, 26). *See* col. 2 lines 59-63.

Independent Claim 58

Appellant's independent claim 58 is directed to a stitch bonded facing fabric (10). *See* col. 2 lines 31-65 and Figures 1, 2, and 5 of Appellant's specification. The stitch bonded facing fabric

(10) includes a first layer of felt (14) having hydrophobic properties and further having an outer surface (20). A plurality of stitch bonding yarns (18) repeatedly extend through the first layer of felt (14) with yarn segments (18') extending across the outer surface (20) of the layer of felt (14), such that the yarn segments extending across the felt layer (14) outer surface (20) cooperate to form a yarn face (24) above the felt layer (14) outer surface (20). The yarn face (24) is effectively continuous such that the outer surface (20) of the layer of felt (14) is not generally exposed at the yarn face (24). *See* col. 2 lines 59-63.

Independent Claim 65

Appellant's independent claim 65 is directed to a stitch bonded facing fabric (10). *See* col. 2 lines 31-65 and Figures 1, 2, and 5 of Appellant's specification. The stitch bonded facing fabric (10) includes a first layer of felt (16) having hydrophilic properties and further having an outer surface (22) and a plurality of stitch bonding yarns (18). The stitch bonding yarns (18) repeatedly extend through the first layer of felt (16) with yarn segments (18'') extending across the outer surface (22) of the layer of felt (16), such that the yarn segments (18'') extending across the felt layer (16) outer surface (22) cooperate to form a yarn face (26) above the felt layer (16) outer surface (26). The yarn face (26) is effectively continuous such that the outer surface (22) of the layer of felt (16) is not generally exposed at the yarn face (26). *See* col. 2 lines 59-63.

Independent Claim 70

Appellant's independent claim 70 is directed to an incontinent pad. *See* col. 3 lines 23-26 and Figures 6 and 7 of Appellant's specification. The incontinent pad includes a facing fabric (10) including a first layer of felt (14) having hydrophobic properties and further having an outer surface

(20), and a plurality of stitch bonding yarns (18) repeatedly extending through the first layer of felt (14) with yarn segments (18') extending across the outer surface (20) of the layer of felt (14). The yarn segments (18') extending across the felt layer (14) outer surface (20) cooperate to form a yarn face (24) above the felt layer (14) outer surface (20). The yarn face (24) is effectively continuous such that the outer surface (20) of the felt layer (14) is not generally exposed at the yarn face (24). A barrier layer (40) is joined to the facing fabric (10).

Independent Claim 80

Appellant's independent claim 80 is directed to an incontinent pad. *See* col. 3 lines 23-26 and Figures 6 and 7 of Appellant's specification. The incontinent pad includes a facing fabric (10) including a first layer of felt (16) having hydrophilic properties and further having an outer surface (22), and a plurality of stitch bonding yarns (18) repeatedly extending through the first layer of felt (16) with yarn segments (18'') extending across the outer surface (22) of the layer of felt (16). The yarn segments (18'') extending across the felt layer (16) outer surface (22) cooperate to form a yarn face (26) above the felt layer (16) outer surface (22). The yarn face (26) is effectively continuous such that the outer surface (22) of the layer of felt (16) is not generally exposed at the yarn face (26). A barrier layer (40) is joined to the facing fabric (10).

VI. Ground(s) of Rejection to be Reviewed on Appeal

1. The rejection of claims 65 and 67-69 under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 4,025,129 to Sternlieb (hereinafter Sternlieb).
2. The rejection of claims 30-37 and 51-64 under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 4,181,514 to Lefkowitz (hereinafter Lefkowitz).
3. The rejection of claims 1, 3-9, 12, 14-20, 30, 32-38, 51, 53-56, 58, 61-66, 68, and 69 under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 4,675,226 to Ott (hereinafter Ott).
4. The rejection of claims 30, 32-36, 39, 41, 42, 46-51, 53-56, 65, 68, 69, 80, 83, 84, 86, and 87 under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 5,356,402 to Gillies (hereinafter Gillies).
5. The rejection of claims 2, 10, 11, 13, 21, 22, 31, 52, 57, 60, and 67 under 35 U.S.C. 103(a) as allegedly unpatentable over Ott
6. The rejection of claims 1, 3-12, 14-23, 26-29, 37, 38, 43, 57, 58, 61-64, 66, 70, 71, 73, 74, 76-79, and 81 under 35 U.S.C. 103(a) as allegedly unpatentable over Gillies in view of Ott.
7. The rejection of claim 25 under 35 U.S.C. 103(a) as allegedly unpatentable over Gillies in view of Ott and in further view of Lefkowitz and U.S. Patent No. 4,128,686 to Kyle (hereinafter Kyle).
8. The rejection of claims 40 and 82 under 35 U.S.C. 103(a) as allegedly unpatentable over Gillies in view of European Patent 261,904 to Taylor (hereinafter Taylor)

9. The rejection of claims 24 and 72 under 35 U.S.C. 103(a) as allegedly unpatentable over Gillies in view of Ott and Taylor.

10. The rejection of claims 31, 44, 45, 52, 67, and 85 under 35 U.S.C. 103(a) as allegedly unpatentable over Gillies in view of Sternlieb.

11. The rejection of claims 2, 13, 59, 60, and 75 under 35 U.S.C. 103(a) as allegedly unpatentable over Gillies in view of Ott and Sternlieb.

12. The rejection of claims 1-87 under 35 U.S.C. 103(a) as allegedly unpatentable over Kyle in view of Gillies, Ott and/or Sternlieb.

VII. Argument

The present re-issue application was filed with claims 1-29 being maintained from the Stern patent and broader claims 30-87 being added. The invention of claims 1-29 is directed to a stitch-bonded facing fabric, an incontinent pad and/or a fluid retaining product in which a felt has hydrophilic and hydrophobic layers or properties; however, whether the felt has only one or both of hydrophobic and hydrophilic properties was deemed not to be critical or essential to the basic invention of a stitch-bonded facing fabric. As a consequence, new claims 30-87 were filed focusing on the concept of yarns stitch bonded to a felt in such a manner as to create at least one yarn face. That concept is present in all of claims 1-87, but with the feature that the felt have both hydrophobic and hydrophilic properties being required only in the original claims. The greater breadth of claims 30-87 was the basis for the Section 112 rejections previously reversed by this Board, and no longer at issue.

In that regard, added claims 30-87 were previously rejected under 35 U.S.C. § 112, first paragraph, as being allegedly based upon a disclosure which was not enabling, while all of the claims, i.e., claims 1-87, were rejected over the aforementioned prior art. Such prior art rejections focused on Examiner's broad interpretation of the term "yarn face" in the claims. The enablement rejection was based solely on Examiner's assertion that the hydrophobic/hydrophilic properties of the web were critical and since they were not cited in the newly-presented claims, enablement was lacking. The enablement rejection was reversed by this Board, although the prior art rejections were upheld based on a broad interpretation of the term "yarn face" which, at the time, did not expressly set forth the interrelationship to the felt as now recited in the claims.

Decision on Appeal mailed January 19, 2005 (Appeal No. 2005-0019).

Appellants subsequently amended each of the independent claims to further recite that the yarn face is "effectively continuous such that" the corresponding "felt" surface "is not generally exposed at the associated yarn face." As a consequence, the felt is not readily visible and/or not able to be easily touched through that yarn face. In that way, a yarn face is created that looks and feels like a soft yarn surface, rather than having the rough look and/or scratchy feel of a felt. Examiner has taken the position that these specific features of the yarn face as recited in the claims are "too subjective" and, so she asserts, can be effectively ignored. Without any basis to do so, Examiner thus unlawfully gives no weight to the very words of the claim in order to rewrite them as if they are the same as they stood in the previous Appeal. In doing so, Examiner also effectively ignores the importance of the interrelationship of the yarn face and the "felt" to thus disregard the proper meaning of that term as well. The blatant purpose of effectively ignoring the words of the claim is to thus, improperly construe the claims as if they were as broad as they were construed in the previous appeal without the added language. Indeed, even a cursory review of the Final Official Actions and its underlying non-final Actions after the RCE, reveals that Examiner's entire-stated basis for the rejections is what she argued in the "Examiner's Answer" in the previous appeal. Hence, Examiner cites the same art against the claims and in the same manner, notwithstanding that the claims have been amended so as to present new, and more narrow, issues for consideration. With the words being given their due weight, Examiner's rejections cannot stand.

Prior to Examiner entering the Final Rejections now on appeal, on February 6, 2006, a Request for Reconsideration was filed in which further support for the claims as now pending was provided by a Declaration of E. Linwood Wright ("Wright Decl.").¹ Mr. Wright is an expert in the textile industry, and is well-qualified to address issues regarding the stitch bonded fabric of the present invention, including the construction thereof, as well as the distinct differences between the stitch bonded fabric and the textile products in the cited art. In his Declaration, Mr. Wright explains that the specification and claims are clearly understood to provide a sufficient level of objectivity to one skilled in the art to interpret "effectively continuous" and "not generally exposed", especially in the contextual relationship of the purpose of a yarn face relative to the "felt". In addition to Mr. Wright's explanations regarding yarn face and the related terminology in the specification and in the claims, Mr. Wright also explained that Examiner's position on the further term "felt" in the claims is overly broad and inconsistent with the nature of the present invention.² Mr. Wright further explains how those terms clearly distinguish the present invention over the prior art. Examiner essentially sweeps all of that under the carpet and instead effectively ignores the very words of the claims, as well as the factually

¹ A copy of the Wright Decl. as filed February 6, 2006, is attached hereto in the Evidence Appendix as Exhibit A. A Supplemental Declaration of E. Linwood Wright (copy attached in the Evidence Appendix as Exhibit B) was filed on February 24, 2006 to make of record Mr. Wright's compensation and that he prepared a declaration for the same assignee in another matter.

² Mr. Wright explains in Paragraph 12 of the Wright Decl. that the ordinary and customary meaning of "felt [is] . . . a nonwoven sheet of matted material . . . such matted material has structural integrity, i.e. tensile strength, in all directions".

based, expert opinion of Mr. Wright.³ The claims as now pending are amended, and raise new issues, including the interplay of the yarn face with the felt, such that the latter is also clearly at issue.

As will be explained in detail below, when the words of the claims are given their due meaning, rather than being effectively ignored, the rejections fail because each item of art cited by Examiner fails to disclose a yarn face that "is effectively continuous such that" the corresponding "felt" surface "is not generally exposed" thereat. Without such disclosure, the rejections are without support and must be reversed.

A. Examiner is Unlawfully Ignoring the Words of the Claim

In the Official Action dated September 10, 2009, which restates the rejections from the Final Official Action of May 2, 2006, Examiner maintains that the added claim language, i.e., that the yarn face "is effectively continuous such that" the "felt" surface "is not generally exposed", is too subjective to be relied upon for distinguishing the present invention from the prior art. Not so. The positive recitation of those features in the claim requires that the Examiner properly construe and consider those terms rather than dismiss them as she seeks to do here. Each element in a claim is deemed material to defining the scope of the invention and cannot be effectively ignored. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S. Ct. 1040, 41 USPQ2d 1865, 1871 (1997); *See also Lemelson v. United States*, 752 F.2d 1538, 1551, 224

³ In Appeal No. 2005-0019, the focus was on the term "yarn face" as it was potentially dispositive of all issues in view of Examiner's prior, and later recanted, indication of favorable consideration of the claims upon amendment to include the additional language further clearly defining "yarn face" as has now been done. Examiner seeks to preclude consideration of the "felt" issue without any basis to do so. As this appeal presents new issues in view of the amended claims, there is no rationale or reason to preclude consideration of all issues presented for patentability to the Examiner.

USPQ 2d 524, 533 (Fed. Cir. 1987) (it is well settled that each element of a claim is material and essential). It also well established that mathematical precision is not required to reasonably convey the claimed subject matter to those of ordinary skill in the art and to distinguish the claimed subject matter from the prior art. Rather, relative terms as used here have long been accepted in patent examination and upheld by the courts. See *Ecolab, Inc. v. Enirochem, Inc.*, 264 F.3d 1358, 1367, 60 USPQ2d 1173 (Fed. Cir. 2001) (quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225 (Fed. Cir. 1995)). Here, terms such as "effectively" and "generally" are sufficient in the context of the present invention to guide one of ordinary skill in the art to understand the metes and bounds of the invention. Thus, Examiner was required (and is always required) to consider all positive limitations recited in the claim. The failure to do so is error that undermines the rejections.

In addition, Examiner asserts without providing lawful support that Appellants have conceded to an unduly broad definition of "felt" for not challenging that definition before the previous appeal. That is not the law,⁴ and indeed, during prosecution after this Board's prior decision, the amendments to the claims and arguments to the Examiner squarely put the term in issue. Examiner's goal is to blatantly ignore the words of the claims in order to make it look as though the claims as amended are still the claims prior to being amended. In that way, Examiner seeks to get away with re-applying the same art and with the same rejections that this Board previously affirmed. But this Board also held that the claims as pending during the prior appeal

were not limited to the yarn face being "effectively continuous such that" the "felt" surface was "not generally exposed" because those words were not in the claims either expressly or through definition of the term "yarn face". They are now. Examiner thus cannot have it both ways, by successfully arguing for a broad construction in the previous appeal to reach the prior art because certain features were not there, and then turning around and effectively ignoring those same features once expressly recited in the claims.

The focus is on the phrase now expressly set forth in the claim that the yarn face "is effectively continuous such that" the "felt" surface "is not generally exposed" at the yarn face. As this language was deemed by the Board not to be present in the claims prior to being amended, there is no basis for the Examiner to assert either that the addition of those words makes no difference or that the meaning of any portion of that phrase is precluded from proper construction.

The present invention has as a primary goal to simulate the effect of a combined facing fabric and felt such as encountered in prior art incontinent pads with stitchbonding that produces a yarn face that, in effect, behaves like a facing fabric with such felt. In other words, the yarn face, like a facing fabric, is sufficiently continuous that the felt is not so exposed that it would present either the rough or scratchy look or feel that is otherwise typically associated with such felts. While precision would be ideal, Appellants submit that it is sufficient that the phrase can be

⁴ See *Abbott Laboratories v. TorPharm Inc.*, 300 F.3d 1367, 63 USPQ2d 1929, 1936 (Fed. Cir. 2002) (an application is to be reviewed on its merits, with all issues open for consideration notwithstanding a prior, adverse Board decision). The present situation is ever more compelling as the interrelationship of felt and yarn face were deemed not to be expressed in the claims as they stood in the previous Appeal.

construed sufficiently to understand what it does not cover,⁵ which here is a yarn face that has gaps through which the surface of the underlying substrate is readily visible on normal viewing or can be readily touched or in which the underlying substrate does not include felt. In this case, the prior art is deficient in that the underlying substrate is either not "felt" and/or the "yarn face" has gaps sufficient to allow the underlying substrate to be readily viewed or touched.

That the phrase in issue is written in relative terms is not dispositive. Indeed, the Federal Circuit has repeatedly held that relative terms are "commonly [and properly] used in patent claims 'to avoid a strict numerical boundary to the specified parameter.'" *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225, 1229 (Fed. Cir. 1995); *See also Andrew Corp v. Gabriel Elecs. Inc.*, 847 F.2d 819, 821-22, 6 USPQ 2010, 2013 (Fed. Cir. 1988) (noting that terms such as "approach each other," "close to," "substantially equal," and "closely approximate" are ubiquitously used in patent claims and that such usages, when serving reasonably to describe the claimed subject matter to those of skill in the field of the invention and to distinguish the claimed subject matter from the prior art, have been accepted in patent examination and upheld by the courts). Thus, that the claim phrase calls for the yarn face to be "effectively" continuous such that the felt surface is not "generally" exposed is nothing more than a recognition that any greater precision would be an unreasonable limitation on the rational reach of these claims. *See, e.g., N. Am. Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335,

⁵ *See, e.g., Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998) where it was not necessary to fully understand the meaning of "when" except to appreciate that it did not reach an occurrence that was at some appreciable time later.

75 USPQ2d 1545 (Fed. Cir. 2005), where the Court held that the addition of "generally" allowed for a more reasonable reading of the term "generally convex" as compared to the term "convex" standing alone. *See also Anchor Wall Sys. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 67 USPQ2d 1865 (Fed. Cir. 2003) where the Court held that "generally parallel," expressly ties the adverb "generally" to the adjective "parallel" such that the ordinary meaning of the phrase "generally parallel" envisions some amount of deviation from exactly parallel.

Following that same rationale and in the environment to which the invention is directed and disclosed, Examiner's approach to the language used demands too much precision and gives too little weight to the context of those words, thus, undermining the premise for her rejections.

To that end, each of the claims specifically recite a plurality of stitch bonding yarns which extend through the felt to create at least one yarn face. That felt is not readily visible and/or not able to be easily touched, through that yarn face. In that way, a yarn face is created that looks and feels like a soft yarn surface, rather than having the rough look and/or scratchy feel of a felt. The stitch bonding yarns are identified by reference number 18 in the Stern patent and include yarn segments 18' and 18" which extend over or across the upper surface 20 of the web and the lower surface 22 of the web, respectively. This arrangement is particularly shown in Figs. 2 and 5 of the Stern patent. The yarn segments contribute to form a top yarn face 24 and/or a bottom yarn face 26 of the finished fabric, which is described in the specification (taken from the Stern patent which is here being sought for reissue) as follows:

It will be appreciated that yarn segments 18' and 18" do not become embedded into the web 12 below surfaces 20 or 22 thereof, but rather

extend across the surfaces 20 and 22, and are of sufficient density that yarn segments 18' cooperate to define a top yarn face 24 of fabric 10 above web upper surface 20, and yarn segments 18" cooperate to define a bottom yarn face 26 of fabric 10 below web lower surface 22. Faces 24 and 26 are effectively continuous such that web 12 is not exposed thereat, although small gaps or interstices (as at 28) between adjacent yarn segments 18' or 18" may allow viewing of felt surface 20 or 22 upon close inspection. It will be noted that Figs. 3 and 4 are greatly exaggerated to show interstices 28 in faces 24 and 26. [underlining added for emphasis] Col. 2, lines 52-65.

The Stern patent further clearly discloses that the yarns for providing the yarn

faces of Applicants' stitch bonded fabric are "of a sufficient density" that the yarn segments 18', 18" cooperate to define, respectively, top and bottom yarn faces of fabric. *See* col. 2, lines 52-59.

To provide these yarn faces of fabric, the Stern patent explains that the yarns 18 may be knitted in a flat stitch construction across the felt upper surface to form underlaps as at 30 in FIG. 3 and overlaps as at 32 in FIG. 4; these underlaps 30 and overlaps 32 are the result of the usual knit construction provided by stitch bonding, such as with existing Malipol-type machines as are known in the art. *See* col. 2, line 66 to col. 3, line 5. The resulting product includes an upper and/or a lower "yarn face", such yarn face being defined as having very closely spaced or densely packed yarn segments of the stitch bonding yarns so as to be effectively continuous such that the felt is not generally exposed. As such, the fabric for the incontinent pad provides a comfortable surface (i.e., facing fabric) for the patient at the top yarn face and/or the bottom yarn face provides a surface, which may be used, for example, for adhesive connection to a barrier layer without interfering with either the structural rigidity or absorbency provided by the felt.

In view of the amount of detail contained in Appellants' specification, the expert Mr. Wright states:

Understandably, one of ordinary skill in the art is readily able to optimize the spacing between the rows of stitch bonded yarns, as based upon yarn density, for a particular application to provide the effectively continuous yarn face(s) of fabric, such stitched yarn face not allowing the felt web surface to be generally exposed upon close inspection. In other words, the felt, or felt web, cannot be readily seen, for example, through the top yarn face unless closely inspected using magnification and does not significantly protrude felt fibers against the patient's skin. Accordingly, effectively continuous means that the felt web surface is "not generally exposed," i.e. not readily viewable through the yarn face without magnification and not readily felt. Wright Decl., Paragraph 10.

Accordingly, the objective instruction provided in the specification, further in combination with the clarifying remarks of the expert Mr. Wright, prove that Appellants' additional claim terminology, which includes "effectively continuous" and "not generally exposed," is definite and provides a sufficient level of objectivity for one of ordinary skill in the art to determine the scope of the claimed invention. To that end, not only can one of ordinary skill in the art make that determination, one can also determine whether the references cited by Examiner disclose such a yarn face. As discussed in detail below, Appellants respectfully assert that the yarn face and its interrelationship with the felt as recited in each of the rejected claims is a feature of the fabric or other product according to this invention that is not shown, disclosed, or otherwise suggested in the cited art.

B. Examiner Refuses to Consider the Real Meaning of "Felt"

Examiner has taken the position that a "felt web" includes "any nonwoven, web or batting comprising discontinuous or staple fibers." Appellants' position is that a "felt web" is a web of felt and that a felt is a matting material that has structural integrity in all directions, which is consistent with the general nature of incontinent pads prior to this invention. Examiner has not taken issue with Appellants' definition but instead refuses to even consider it. As Appellants' definition was presented to Examiner during prosecution, Examiner is unlawfully denying Appellants' due process by her refusal.

Examiner's position is premised on the weak reed that even though prosecution was not closed, Appellants cannot raise the issue because it was not raised in the previous appeal. That is not the law. In *Abbott Laboratories v. TorPharm Inc.*, 63 USPQ2d 1929, 1936 (Fed. Cir. 2002), the Court made clear that an unappealed decision of this Board is not binding on further prosecution such as in a continuation application. That holding was premised on the long-standing rule of law that a continuation application is to be reviewed on its merits, with all issues open for consideration notwithstanding a prior, adverse Board decision. Certainly, if an unappealed Board decision is not preclusive as to issues already decided, Appellants were entitled to full consideration of its position on the term "felt" when this case went back to the Examiner pursuant to the RCE. That is all the more so as that issue was not previously considered by this Board.⁶

⁶ Examiner makes much of the duration of this case, but the facts belie her concerns. The application was first filed in April 2000 and, after only two Official Actions, ended up on Appeal a short one and a half years later in September 2001. That Appeal was not decided until January 2005. Appellants presented their RCE and amended claims shortly

It is recognized that claims must be interpreted as broadly as their terms reasonably allow during examination. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). Without a clear definition in the specification, the words of the claims must be given their plain meaning, i.e. their ordinary and customary meaning, which is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application. *Phillips v. AWH Corp.*, 376 F.3d 1382, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*); *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) (In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art).

The Stern patent discusses the invention in terms of incontinent pads and that the typical incontinent pad includes a felt layer. Such felt layers are generally recognized in the relevant art as requiring that it be a matted material with structural integrity in all directions because it was a web of material to which is going to be applied a separately formed facing fabric. Hence, the felt could not just be any sort of substrate "comprising discontinuous or staple fibers" as Examiner contends. Mr. Wright confirms that "felt" is so understood by a person of ordinary skill in the art. Indeed, Mr. Wright explains that "Examiner has improperly defined Applicants'

thereafter in April 2005. The Examiner issued an Official Action on August 8, 2005, which was only the third action in this case. Appellants responded within the lawful time limits with arguments and evidence regarding this issue. As that Official Action was not final, Appellants were entitled to full consideration of the issues and should not have held against

'felt web' and has provided a grossly, overly broad interpretation ...[insofar as Applicants'] 'felt web' [is]...a nonwoven sheet of matted material...such matted material has structural integrity, i.e. tensile strength, in all directions." Wright Decl., Paragraph 12.

The Wright Decl. is irrefutable evidence that Examiner's definition is wrong and fails to consider the proper meaning of "felt" in the context of the invention as disclosed in the Stern patent. Had Examiner properly considered that context, she could not have ignored Mr. Wright's Declaration confirming the ordinary and customary meaning of "felt" in this art.⁷

C. The Cited Art Neither Discloses nor Renders Obvious the Claimed Invention

1. Overview

The claims presently stand rejected either as anticipated or for obviousness. For present purposes, focus will be on the independent claims, for if the rejections thereof fall, the rejections of the dependent claims necessarily must fall. *See, e.g., Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987) (dependent claims not obvious if independent claims not obvious over the art). Appellants do not, however, waive the right to present arguments directed specifically to the dependent claims should that become necessary.

Independent claim 65 stands rejected under §102(b) as being anticipated by Sternlieb; independent claims 30 and 51 stand rejected under §102(b) as being anticipated by

them that more than half the life of their application was consumed on Appeal.

⁷ Mr. Wright is an expert in this area and sets out in detailed fashion the support for his conclusions. Examiner's mere incantation that she can ignore his Declaration as conclusory opinion is wrong as a matter of fact and deficient as a matter of law. Examiner provides no substantive evaluation of the evidence, no substantive explanation as to what she found unpersuasive, nor any reference to contrary evidence. General statements without explanation supporting such

Lefkowitz; independent claims 1, 12, 30, 51, 58, and 65 stand rejected under §102(b) as being anticipated by Ott; and independent claims 30, 39, 51, and 80 stand rejected under §102(b) as being anticipated by Gillies. With respect to the obviousness rejections, independent claims 1, 12, 23, and 70 are rejected under ' 103(a) as being unpatentable over Gillies in view of Ott, and independent claims 1, 12, 23, 39, 51, 58, 65, 70 and 80 are rejected under ' 103(a) as being unpatentable over Kyle in view of Gillies, Ott and/or Sternlieb. Various of the dependent claims stand rejected on the above art and/or citing further secondary references.

As it is submitted that the rejections of the independent claims cannot stand, the rejections of the dependent claims are also submitted to be in error and thus moot. Appellants do not, however, waive the right to present further or additional arguments as may later prove necessary. Rather, for present purposes, it is believed sufficient to establish that the cited art fails to disclose a stitch bonded yarn face which is "effectively continuous such that" the "felt" surface is "not generally exposed" as those terms are properly understood. All of the claims expressly require that combination which, as will be explained below, is not taught, suggested, or disclosed by the art as cited by Examiner.

2. The Cited Art Does Not Anticipate the Claimed Inventions

It is well established that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For the reasons listed below, each of Sternlieb, Lefkowitz, Gillies,

and Ott clearly fail to teach each and every element of Applicants' invention such that the §102 rejections cannot be sustained.

a. Claim improperly rejected under 35 U.S.C. § 102(b) as anticipated by Sternlieb

Independent Claim 65

Sternlieb is directed to a dimensionally stable fabric especially useful for bed sheets, or for the uppers of footwear such as sneakers, athletic shoes, etc. This dimensionally stable fabric includes a layer or web of carded fibers 1 reinforced by a woven fabric layer 9, such layer of carded fibers being unbonded, uncompacted, and unmatted and of intermingled, non-parallel fibers. *See* Abstract; col. 1, lines 31-40; col. 2, lines 20-26.

At the outset, the layer of web or carded fiber 1 is not felt. If that loose layer were attempted to be used as a felt in a prior art incontinent pad, there would be no way for one to effectively handle it in its own right or to reliably attach it to a facing fabric without the layer falling apart, either during handling, or perhaps even after attachment. Hence, it cannot be a felt as required by the claims. The expert agrees: "to one skilled in the art, these layers of unmatted carded fibers and of woven fabric are not felts." Wright Decl., Paragraph 13.

In addition, the two layers 1, 9 of the fabric are stitch bonded together by knitting yarns 11, 13. The stitches from knitting yarns 11, 13 in Fig. 7 of Sternlieb are shown spaced significantly from one another, and with portions of the layer as at 31 extending out from the stitchbonding yarns. It is undeniable that with such a construction, there are portions of a layer that are readily visible and easily touched. No matter what interpretation Examiner might want to give to the claims, such clearly exposed material means that yarn face of Sternlieb is not

"effectively continuous such that" the "felt" surface "is not generally exposed". The expert confirms that "it is abundantly clear to one skilled in the art that Sternlieb fails to teach, disclose or otherwise suggest any yarn face as recited in Applicants' claims." Wright Decl., Paragraph 11.

b. Claims improperly rejected under 35 U.S.C. § 102(b) as anticipated by Lefkowitz

Independent claims 30 and 51

Lefkowitz discloses a stitch knitted filter for high temperature fluids including a fibrous batt 2 of relatively brittle fibers with a number of stitch yarns 3, 4 significantly spaced from one another as shown particularly in Figs. 3 and 7 of that reference.

Lefkowitz concedes that the batt does not have structural integrity in its own right because it requires the combination of the batt and stitch yarns to "achieve . . . structural integrity". Col. 4, line 5. As Mr. Wright further explains, "to one skilled in the art, a batt of relatively brittle, unmatted fibers is not a felt." Wright Decl., Paragraph 13.

Additionally, as seen in all of the drawings of Lefkowitz, the stitching yarns are spaced well apart from one another. The batt material is quite readily seen and touched. Indeed, that must be so in order for the batt to perform the filter function without being obstructed by the stitching yarns. The expert confirms that "if the stitch yarns [of Lefkowitz] produced an effectively continuous yarn face as claimed in Applicants' invention, then the filtered material is not able to escape the allegedly effectively continuous face. Therefore, the stitch yarns in Lefkowitz cannot be effectively continuous." Wright Decl., Paragraph 11.

c. Claims improperly rejected under 35 U.S.C. § 102(b) as anticipated by Ott
Independent claims 1, 12, 30, 51, 58, and 65

The Ott patent is directed to a stitch bonded composite wiper 70 having strength and absorbency performance and other features for a variety of industrial, institutional and health care wiping uses. The stitch bonded composite wiper 70 includes a middle layer 78 of cellulose natural fibers and outer layers 76, 74 of continuous filament thermoplastic fibers, meltblown thermoplastic microfibers, or rayon fibers. *See* Abstract; col. 2, lines 30-34; Fig. 2.

Ott concedes that its middle layer 78 and outer layers 74, 76 are not felts. More specifically, those layers 74, 76, 78 are disclosed as being low cost alternatives to many nonwoven wipers, for example. *See* col. 1, lines 23-29; and col. 2, lines 40-45. In addition, such layers 74, 76 are formed via spunbonding methods while layer 78 is wet or dry formed, with neither layer resulting in a matted material. *See* col. 2, line 64 to col. 3, line 4. Furthermore, the absorbent middle layer of cellulose natural fibers fails to provide structural integrity in all directions, which would be required in order for it to be handled as a felt and to be attached to a facing fabric. The material of Ott would likely fall apart or into pieces were it to be handled and attached to a facing fabric. Hence, none of layers 74, 76, 78 can be a felt as they are neither nonwoven nor matted, with the absorbent middle layer clearly lacking structural integrity. In support thereof, the expert agrees that the "unmatted inner and outer layers are not felt to one skilled in the art." Wright Decl., Paragraph 13.

d. Claims improperly rejected under 35 U.S.C. § 102(b) as anticipated by Gillies

Independent claims 30, 39, 51, and 80

Gillies discloses a reusable diaper including a median layer 14 of carded and crosslaid viscose rayon fibers having a cross-section of substantially rigid multi-limbed

configuration. This median layer must be stitch bonded in order to be a cohesive unit and so that it can maintain dispersion and absorbency integrity. The stitch-bonded median layer is then hidden within the diaper by being incorporated between outer layers 12 and 16. *See* Abstract; col. 5, lines 8 and 23-27; col. 5, line 64 to col. 6, line 13; Fig. 1.

The median layer of Gillies is specifically formed from carded and crosslaid viscose rayon fibers. Unlike felt, which in its own right is a cohesive unit and has the structural integrity to retain fluid and withstand repeated usages, Gillies explains that their median layer material lacks those qualities. The Gillies median layer material must be stitch-bonded to be "maintained as a cohesive unit" (col. 5, line 8) and to achieve the required integrity (col. 5, lines 23-27). The median layer of Gillies is thus not a matted material like a felt, and does not have the required structural integrity in its own right without the stitch bonding. Thus, the median layer of Gillies is not felt, which is confirmed by the expert: "to one skilled in the art, this median layer of carded and crosslaid viscose rayon fibers is not matted and, thus, not a felt." Wright Decl., Paragraph 13.

* * * * *

For all of the above reasons, each of Sternlieb, Lefkowitz, Gillies, and Ott clearly fail to teach each and every element of Applicants' stitch bonded fabric face as recited in independent claims 1, 12, 23, 30, 39, 51, 58, 65, 70, and 80, and their dependent claims. Hence, the anticipation rejections under Section 102 are in error and should be reversed.⁸

⁸ Moreover, none of the art cited as anticipating any of the claims discloses an incontinent pad as required by claims 39-50 and 70-87 in any event.

3. The Cited Art Does Not Render Obvious the Claimed Inventions

The Section 103 rejections can be broken down into two groups. In the first group, the independent claims are rejected on the basis of Gillies in view of Ott. In the other group, the independent claims are rejected on the basis of Kyle in view of Gillies, Ott and/or Sternlieb. The dependent claims are rejected on the basis of the foregoing and/or with additional art, but it is submitted that the rejections of the independent claims are in error, thus mooted the rejections of the dependent claims.⁹

a. Claims improperly rejected under 35 U.S.C. § 103(a) over Gillies in view of Ott

Independent claims 1, 12, 23, 51, 58, 65, 70, and 80

As explained above, Gillies fails to reach the claimed invention as Gillies does not disclose a "felt". Similarly, Ott fails to reach the claimed invention for at least that same reason. Even were it obvious to have combined Gillies and Ott, Examiner cannot show that the result would include "felt". Hence, the obviousness rejections based on the combination of Gillies and Ott are flawed and should be reversed.

b. Claims improperly rejected under 35 U.S.C. § 103(a) over Kyles in view of Gillies, Ott and/or Sternlieb

Independent claims 1, 12, 23, 39, 51, 58, 65, 70, and 80

⁹ No independent claims are rejected over Taylor as a primary reference, and Taylor is relied upon only in rejection of dependent claims. Hence, Appellants do not see a need here to argue the details of Taylor, but it should be understood that such a view is without waiver of the right to present arguments later if necessary.

Turning now to the second group of obviousness rejections, they are all based on Kyle as the primary reference, with Gillies, Ott, and/or Sternlieb serving as the secondary references.

Kyle is an example of an incontinent pad of the prior art which has a facing fabric (upper sheet 25) which is either simply placed over, or can be quilted to, a felt (absorbent sheet 23 of needle-viscose rayon). While Examiner cites to Ott, Gillies, or Sternlieb for their stitch-bonding yarns, Examiner nowhere explains why it would have been obvious to modify Kyle to accommodate the stitch-bonding of these references. Indeed, absent hindsight reconstruction based on Appellants' present disclosure, it is submitted that there would have been no basis to modify Kyle in light of any of Ott, Gillies and/or Sternlieb. Nor would the result be the claimed invention in any event.

Turning first to Sternlieb, why would one throw away the facing fabric of Kyle in favor of the stitching yarns of Sternlieb? In Sternlieb, the stitching yarns are necessary to hold the loose layer together. The felt of Kyle is its own, stable layer, and does not need stitching yarns to hold it together. For that reason alone, Sternlieb does not provide support for Examiner's 103 rejections. In any event, even were Kyle to be modified to have the stitching of Sternlieb, the result would not be the claimed invention. As explained above in connection with the Section 102 rejections based on Sternlieb, the stitching there results in gaps through which the felt is exposed, contrary to the claim requirement of a yarn face that "is essentially continuous" such that the surface of the felt "is not generally exposed".

Examiner's reliance on Gillies and Ott is equally flawed. As with Sternlieb, in Gillies, the stitching is required in order to maintain the median layer as a cohesive unit and to achieve the required integrity in order that the medial layer can be buried between outer layers of a diaper. As the felt of Kyle already suffices in its own right, why would one bother to modify that incontinent pad based on Gillies? Moreover, why would one be motivated to throw away the facing fabric of Kyle in favor of the Gillies stitch-bonding, when it would not appear to serve any purpose to do so? Examiner completely ignores the very purpose of stitch-bonding in Gillies, and instead randomly picks out of Gillies the stitch-bonded yarn face as if its mere existence would be sufficient to support an obviousness rejection. That is error as a matter of hornbook law.

Moreover, as explained by the expert:

Gillies' stitch bonded median layer, as already discussed above, is incorporated between outer layers 12 and 16, thereby effectively hiding within the diaper any yarn face presented on the surface of the median layer. In stark contrast, Applicants' stitch bonded fabric includes a stitch bonded yarn face on the outside of the product to provide a soft, comfortable surface for a patient. Clearly, it is nonsensical, certainly to one skilled in the art, to combine Gillies' stitch bonded median layer with any reference, let alone Kyle, to provide Applicants' stitch bonded fabric having a yarn face that is situated on the outside of the product. Wright Decl., Paragraph 16.

Nor is there reason or motivation to simply pick out the stitch-bonding of Ott in favor of the facing fabric of Kyle. Rather, like Gillies, the stitch-bonding of Ott is necessary to hold the material together. Since that is not at all a concern with Kyle, inasmuch as the felt is its own structurally integral web, there is no reason to take anything from Ott to motivate a change to Kyle. Indeed, Ott is a wiper product and so is intended to present an abrasive surface, which is

directly at odds with the nature of at least the top yarn face of the present invention. The expert confirmed that there is no motivation to combine "the wiper product of Ott with an incontinent pad, such as is disclosed in Kyle, in an effort to arrive at Applicants' fabric face product." Wright Decl., Paragraph 16.

* * * * *

In view of the foregoing, it is respectfully submitted that the obviousness rejections are in error and should be reversed.

Conclusion

For at least the reasons discussed above, Appellant respectfully submits that the rejections of claims 1-87 are in error and should be reversed.

Respectfully submitted,

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VIII. Claims Appendix

1. (ONCE AMENDED) A stitch bonded facing fabric comprising:

a first layer of hydrophobic felt;

a second layer of hydrophilic felt being adjacent to the first layer so as to define a felt web having an upper surface defined by an upper side of the first layer and a lower surface defined by a lower side of the second layer; and

a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface;

wherein each yarn face is effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face.

2. The stitch bonded fabric of claim 1 further comprising a scrim layer interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.

3. The facing fabric of claim 1 wherein the yarn segments extending across the felt web upper surface form underlaps.

4. The facing fabric of claim 3 wherein the yarn segments extending across the felt web lower surface form overlaps.
5. The facing fabric of claim 1 wherein the yarn segments extending across the felt web lower surface form overlaps.
6. The facing fabric of claim 1 wherein the yarns are stitched in a flat stitch construction across the felt web upper surface.
7. The facing fabric of claim 1 wherein the yarns are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the top yarn face.
8. The facing fabric of claim 1 wherein the yarns are hydrophobic.
9. The facing fabric of claim 1 wherein the yarns are hydrophilic.
10. The facing fabric of claim 1 wherein the yarns are continuous filaments.
11. (TWICE AMENDED) The facing fabric of claim 1 wherein the yarns of each yarn face are not embedded into the associated surface of the web [[spun yarn]].
12. (ONCE AMENDED) A stitch bonded facing fabric comprising:
a felt web having a hydrophobic upper aspect extending from an upper surface of the web and
a hydrophilic lower aspect extending from a lower surface of the web; and

a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface;

wherein each yarn face is effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face.

13. The stitch bonded fabric of claim 12 further comprising a scrim layer interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.

14. The facing fabric of claim 12 wherein the yarn segments extending across the felt web upper surface form underlaps.

15. The facing fabric of claim 14 wherein the yarn segments extending across the felt web lower surface form overlaps.

16. The facing fabric of claim 12 wherein the yarn segments extending across the felt web lower surface form overlaps.

17. The facing fabric of claim 12 wherein the yarns are stitched in a flat stitch construction across the felt web upper surface.

18. The facing fabric of claim 12 wherein the yarns are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the fabric top.
19. The facing fabric of claim 12 wherein the yarns are hydrophobic.
20. The facing fabric of claim 12 wherein the yarns are hydrophilic.
21. The facing fabric of claim 12 wherein the yarns are continuous filaments.
22. (TWICE AMENDED) The facing fabric of claim 12 wherein the yarns of each yarn face are not embedded into the associated surface of the web [[spun yarn]].

23. (ONCE AMENDED) A fluid-retaining fabric comprising:

a stitch bonded facing fabric having a first layer of hydrophobic felt, a second layer of hydrophilic felt being adjacent to the first layer so as to define a felt web having an upper surface defined by an upper side of the first layer and a lower surface defined by a lower side of the second layer, and a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface;

wherein each yarn face is effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face; and

a barrier layer attached to the bottom yarn face.

24. The fluid-retaining fabric of claim 23 further comprising adhesive attaching the barrier layer to the bottom yarn face.

25. The fluid-retaining fabric of claim 23 wherein the first and second felt layers are needle punched into a single felt web.

26. The fluid-retaining fabric of claim 23 wherein the barrier layer includes a fluid barrier ply and a fabric ply.

27. The fluid-retaining fabric of claim 26 wherein the barrier ply is attached to the bottom yarn face.
28. The fluid-retaining fabric of claim 23 wherein the barrier layer includes a fluid barrier ply.
29. The fluid-retaining fabric of claim 23 further comprising edge stitching attaching the barrier layer to the bottom yarn face.
30. (ONCE AMENDED) A stitch bonded facing fabric comprising:
a felt web having an upper surface and a lower surface; and
a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface;
wherein each yarn face is effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face.
31. The stitch bonded facing fabric of claim 30 further comprising a scrim layer interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.
32. The stitch bonded facing fabric of claim 30 wherein the yarn segments extending across the

felt web upper surface form underlaps.

33. The stitch bonded facing fabric of claim 32 wherein the yarn segments extending across the felt web lower surface form overlaps.

34. The stitch bonded facing fabric of claim 30 wherein the yarn segments extending across the felt web lower surface form overlaps.

35. The stitch bonded facing fabric of claim 30 wherein the yarns are stitched in a flat stitch construction across the felt web upper surface.

36. The stitch bonded facing fabric of claim 30 wherein the yarns are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the fabric top.

37. The stitch bonded facing fabric of claim 30, the felt web including first and second felt layers being adjacent to one another to define the felt web, the upper surface of the web being defined by an upper side of the first felt layer, the lower surface of the web being defined by a lower side of the second felt layer, the stitch bonded yarns extending through both felt layers.

38. The stitch bonded facing fabric of claim 30 wherein the yarns are hydrophilic.

39. (ONCE AMENDED) An incontinent pad comprising:
a stitch bonded facing fabric having a felt web having an upper surface and a lower surface
and a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments

extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface;

wherein each yarn face is effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face; and

a barrier layer joined to the facing fabric so as to confront the bottom yarn face of the facing fabric.

40. The incontinent pad of claim 39 further comprising adhesive attaching the barrier layer to the bottom yarn face.

41. The incontinent pad of claim 39 further comprising edge stitching attaching the barrier layer to the bottom yarn face.

42. The incontinent pad of claim 39 wherein the barrier layer includes a fluid barrier ply and a fabric ply.

43. The incontinent pad of claim 39, the felt web of the stitch bonded facing fabric including first and second felt layers being adjacent to one another to define the felt web, the upper surface of the web being defined by an upper side of the first felt layer, the lower surface of the web being defined by a lower side of the second felt layer, the stitch bonded yarns extending through both felt layers.

44. The incontinent pad stitch of claim 39 further comprising a scrim layer in the stitch bonded facing fabric and being interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.
45. The incontinent pad of claim 44, the scrim layer being interposed between the felt web lower surface and the yarn segments extending thereacross.
46. The incontinent pad of claim 39 wherein the yarn segments extending across the felt web upper surface of the stitch bonded facing fabric form underlaps.
47. The incontinent pad of claim 39 wherein the yarn segments extending across the felt web lower surface of the stitch bonded facing fabric form overlaps.
48. The incontinent pad of claim 39 wherein the yarns of the stitch bonded facing fabric are stitched in a flat stitch construction across the felt web upper surface.
49. The incontinent pad of claim 39 wherein the yarns of the stitch bonded facing fabric are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the fabric top.
50. The incontinent pad of claim 39 wherein the yarns of the stitch bonded facing fabric are hydrophobic.

51. (ONCE AMENDED) A fluid retaining fabric comprising:

a felt web having an upper surface and a lower surface, the felt being adapted to retain fluid therein; and

a plurality of stitch bonding yarns repeatedly extending though the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface, the stitch bonding yarns being hydrophobic whereby to assist in wicking fluid into the felt web;

wherein each yarn face is effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face.

52. The fluid retaining fabric of claim 51 further comprising a scrim layer interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.

53. The fluid retaining fabric of claim 51 wherein the yarn segments extending across the felt web upper surface form underlaps.

54. The fluid retaining fabric of claim 51 wherein the yarn segments extending across the felt web lower surface form overlaps.

55. The fluid retaining fabric of claim 51 wherein the yarns are stitched in a flat stitch construction across the felt web upper surface.
56. The fluid retaining fabric of claim 51 wherein the yarns are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the fabric top.
57. The fluid retaining fabric of claim 51 wherein the yarns are continuous filaments.
58. (ONCE AMENDED) A stitch bonded facing fabric comprising:
a first layer of felt having hydrophobic properties and further having an outer surface; and
a plurality of stitch bonding yarns repeatedly extending through the first layer of felt with yarn segments extending across the outer surface of the layer of felt, such that the yarn segments extending across the felt layer outer surface cooperate to form a yarn face above the felt layer outer surface;
wherein the yarn face is effectively continuous such that the outer surface of the layer of felt is not generally exposed at the yarn face.
59. The stitch bonded facing fabric of claim 58 further comprising a second layer of felt adjacent the first layer and having the stitch bonding yarns repeatedly extending therethrough.
60. The stitch bonded facing fabric of claim 58 further comprising a scrim layer interposed between the felt layer outer surface and the yarn segments extending thereacross.

61. The stitch bonded facing fabric of claim 58 wherein the yarn segments extending across the felt web outer surface form underlaps.
62. The stitch bonded facing fabric of claim 58 wherein the yarns are stitched in a flat stitch construction across the felt web outer surface.
63. The stitch bonded facing fabric of claim 58 wherein the yarns are stitched in a loop knit construction across the felt web outer surface to define a plurality of yarn loops.
64. The stitch bonded facing fabric of claim 58 wherein the yarns are hydrophobic.
65. (ONCE AMENDED) A stitch bonded facing fabric comprising:
a first layer of felt having hydrophilic properties and further having an outer surface; and
a plurality of stitch bonding yarns repeatedly extending through the first layer of felt with yarn segments extending across the outer surface of the layer of felt, such that the yarn segments extending across the felt layer outer surface cooperate to form a yarn face above the felt layer outer surface;
wherein the yarn face is effectively continuous such that the outer surface of the layer of felt is not generally exposed at the yarn face.
66. The stitch bonded facing fabric of claim 65 further comprising a second layer of felt adjacent the first layer and having the stitch bonding yarns repeatedly extending therethrough.

67. The stitch bonded facing fabric of claim 65 further comprising a scrim layer interposed between the felt layer outer surface and the yarn segments extending thereacross.

68. The stitch bonded facing fabric of claim 65 wherein the yarn segments extending across the felt web outer surface form overlaps.

69. The stitch bonded facing fabric of claim 65 wherein the yarns are hydrophobic.

70. (ONCE AMENDED) An incontinent pad comprising:

a facing fabric including a first layer of felt having hydrophobic properties and further having an outer surface, and a plurality of stitch bonding yarns repeatedly extending through the first layer of felt with yarn segments extending across the outer surface of the layer of felt, such that the yarn segments extending across the felt layer outer surface cooperate to form a yarn face above the felt layer outer surface;

wherein the yarn face is effectively continuous such that the outer surface of the felt layer is not generally exposed at the yarn face; and

a barrier layer joined to the facing fabric.

71. The incontinent pad of claim 70, the facing fabric further including a second layer of felt adjacent the first layer and having the stitch bonding yarns repeatedly extending therethrough.

72. The incontinent pad of claim 70 further comprising adhesive attaching the barrier layer to the facing fabric.
73. The fluid-retaining fabric of claim 70 further comprising edge stitching attaching the barrier layer to the facing fabric.
74. The incontinent pad of claim 70 wherein the barrier layer includes a fluid barrier ply and a fabric ply.
75. The incontinent pad of claim 70 further comprising a scrim layer in the facing fabric and being interposed between the felt web outer layer and the yarn segments extending thereacross.
76. The incontinent pad of claim 70 wherein the yarn segments extending across the felt web outer surface of the facing fabric form underlaps.
77. The incontinent pad of claim 70 wherein the yarns of the facing fabric are stitched in a flat stitch construction across the felt web outer surface.
78. The incontinent pad of claim 70 wherein the yarns of the facing fabric are stitched in a loop knit construction across the felt web outer surface to define a plurality of yarn loops.
79. The incontinent pad of claim 70 wherein the yarns of the facing fabric are hydrophobic.

80. (ONCE AMENDED) An incontinent pad comprising:
a facing fabric including a first layer of felt having hydrophilic properties and further having an
outer surface, and a plurality of stitch bonding yarns repeatedly extending through the first layer of felt
with yarn segments extending across the outer surface of the layer of felt, such that the yarn
segments extending across the felt layer outer surface cooperate to form a yarn face above the
felt layer outer surface;
wherein each yarn face is effectively continuous such that the outer surface of the layer of
felt is not generally exposed at the yarn face; and
a barrier layer joined to the facing fabric.
81. The incontinent pad of claim 80, the facing fabric further including a second layer of felt
adjacent the first layer and having the stitch bonding yarns repeatedly extending therethrough.
82. The incontinent pad of claim 80 further comprising adhesive attaching the barrier layer to the
facing fabric.
83. The fluid-retaining fabric of claim 80 further comprising edge stitching attaching the barrier
layer to the facing fabric.
84. The incontinent pad of claim 80 wherein the barrier layer includes a fluid barrier ply and a
fabric ply.

85. The incontinent pad stitch of claim 80 further comprising a scrim layer in the facing fabric and being interposed between the felt web outer layer and the yarn segments extending thereacross.
86. The incontinent pad of claim 80 wherein the yarn segments extending across the felt web outer surface of the facing fabric form overlaps.
87. The incontinent pad of claim 80 wherein the yarns of the facing fabric are hydrophobic.

IX. Evidence Appendix

Exhibit A – Declaration of E. Linwood Wright Pursuant to 37 C.F.R. §1.132 filed on February 6, 2006.

Exhibit B – Supplemental Declaration of E. Linwood Wright Pursuant to 37 C.F.R. §1.132 filed on February 24, 2006.

Examiner previously considered these declarations in the Final Office Action mailed on May 2, 2006.

X. Related Proceedings Appendix

Exhibit C – Decision on Appeal mailed January 19, 2005 (Appeal No. 2005-0019).

Exhibit D – Response to Request for Rehearing mailed on March 25, 2005 (Appeal No. 2005-0019).

Exhibit E – Order Returning Undocketed Appeal mailed on March 17, 2009.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/558,329
Filed: 04/25/2000
Art Unit: 1711
Examiner: Cheryl Juska
Applicant: Stern et al.
Title: Stitch Bonded Fabric and Fluid-Retaining Fabric Made Therewith
Conf. No.: 9722

**DECLARATION OF E. LINWOOD WRIGHT
PURSUANT TO 37 C.F.R. § 1.132**

I, E. Linwood Wright, declare as follows:

1. I make this declaration in support of the above-captioned application, and submit that I am skilled in the art to which the invention pertains. I have attached a copy of my curriculum vitae to this declaration.
2. I earned a Bachelor of Science degree in Chemistry, and a Master of Science degree in Physical Chemistry, both from Duke University in Durham, North Carolina. In addition, I completed the Executive Program at the University of Virginia's Darden Graduate School of Business in Charlottesville, Virginia.
3. I have worked in the textile industry for the past forty-nine years, having spent all of that time in various positions with Dan River Inc. of Danville, Virginia. I began my career with Dan River in 1956 as a research chemist, had numerous roles and responsibilities in research and development, culminating in my role as Vice President of Research and Development. I retired in 2004 as Vice President of Quality and Development. Since that time, I have continued to work with Dan River on a consulting basis.



4. For over thirty years during my tenure at Dan River, I was responsible for a wide variety of fabrics, including design thereof, fabric quality, and product quality, such fabrics being used in apparel and for home and industrial products. Over that time, I have gained extensive experience with, and broad knowledge about, textiles, textile materials, and textile processing, as well as the techniques, including stitching and knitting techniques, used for the construction of textile products, such as the stitch bonded fabric of the present invention. In addition, my primary personal responsibility for the last twenty years has been product, and end-use, innovation.

5. During my career, I also have chaired various professional association committees, including committees directed to product lines that encompass apparel, upholstery, bedding, and other home textile products. I chaired both the consumer products committee and the home textiles subcommittee of the former American Textile Manufacturer's Institute, and I currently chair the home textiles committee of the National Textile Association, which is concerned primarily with top of the bed items.

6. Dan River Inc. is a textile supplier to the assignee of the above-referenced application.

7. I believe that I am qualified to address issues regarding the stitch bonded fabric of the present invention, including the construction thereof, as well as the distinct differences between said stitch bonded fabric and the textile products in the prior art currently cited by Examiner.

8. I am familiar with the prosecution of the above-referenced matter. In particular, I have read U.S. Patent No. 5,902,757 ("Stern") and the pending claims (as presented in the April 29, 2005 reply), the August 5, 2005 office action, including the cited prior art¹, the May 14, 2004 reply brief, and the March 15, 2004 Examiner's Answer.

9. Having considered these materials, I understand that Appellant, in response to the Board's Decision, amended each of the independent claims in their April 29, 2005 reply further defining the stitch bonded yarn face(s) of the present invention to be effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face. I further understand that Examiner has continued to reject all pending claims, 1-87, based upon one or more of Sternlieb, Lefkowitz, Ott, Gillies, Kyle, and Taylor. More specifically, one of Examiner's primary positions is that the newly added claim language "effectively continuous" and "not generally exposed," which further defines the stitch bonded yarn face(s), is too subjective to be relied upon for distinguishing the present invention from the prior art. I respectfully disagree.

10. One skilled in the art appreciates that the additional terminology further defining the yarn faces of the present invention, in fact, provides a sufficient level of objectivity which can be relied upon for distinguishing the present invention from the prior art. Notably, Stern clearly discloses that the yarns for providing the yarn faces of Applicants' stitch bonded fabric are "of a sufficient density" such that the yarn segments 18', 18'' cooperate to define, respectively, top and bottom yarn faces of fabric. See col. 2, lines 52-59. To provide these yarn

¹ U.S. Patent No. 4,026,129 ("Sternlieb"), U.S. Patent No. 4,181,514 ("Lefkowitz"), U.S. Patent No. 4,675,226 ("Ott"), U.S. Patent No. 5,356,402 ("Gillies"), U.S. Patent No. 4,128,686 ("Kyle"), and European Patent No. 261,904 ("Taylor").

faces of fabric, Stern further explains that the yarns 18 are knitted in a flat stitch construction across the felt web upper surface to form underlaps as at 30 in FIG. 3 and overlaps as at 32 in FIG. 4, such underlaps 30 and overlaps 32 being the result of the usual knit construction provided by stitch bonding, such as with existing Malipol-type machines as are known in the art. See col. 2, line 66 to col. 3, line 5. Noticeably, a benefit of such a yarn face is that the fabric, such as for an incontinent pad, provides a comfortable surface for a patient at the top yarn face. In addition, the bottom yarn face provides a surface that may be used, for example, for adhesive connection to a barrier layer without interfering with either the structural rigidity or absorbency provided by the felt web. Understandably, one of ordinary skill in the art is readily able to optimize the spacing between the rows of stitch bonded yarns, as based upon yarn density, for a particular application to provide the effectively continuous yarn face(s) of fabric, such stitched yarn face not allowing the felt web surface to be generally exposed upon close inspection. In other words, the felt, or felt web, cannot be readily seen, for example, through the top yarn face unless closely inspected using magnification and does not significantly protrude felt fibers against the patient's skin. Accordingly, "effectively continuous" means that the felt web surface is "not generally exposed," i.e. not readily viewable through the yarn face without magnification and not readily felt. Clearly, the effectively continuous nature of the yarn face is definite and a standard is provided for one of ordinary skill in the art to determine the scope of the claimed invention for distinguishing the present invention from the prior art.

11. To one skilled in the art, neither Sternlieb nor Lefkowitz disclose the stitch bonded yarn face of the present invention. More specifically, the stitch-bonding yarns in the present

case provide an effectively continuous face; whereas stitched knitting yarns 11, 13 in Fig. 7 of Sternlieb are spaced significantly from one another, thereby providing a substantial amount of exposed scrim sheet 9 and web of cardable fibers 1. It is abundantly clear to one skilled in the art that Sternlieb fails to teach, disclose or otherwise suggest any yarn face as recited in Applicants' claims. Concerning Lefkowitz, this patent is directed to a filter including a fibrous bat 2 with a number of stitch yarns 3, 4 significantly spaced from one another as shown particularly in Figs. 3 and 7 of that reference.² The stitch yarns 3, 4 "comprise metallic monofilament or multi filament yarns or glass multi filament yarns. Such yarns may be used alone or in combination with other non-metallic yarn materials." See col. 3, lines 1-4. Since Lefkowitz is directed to a filter, inherently, a fluid or other medium must pass through the fibrous bat and stitch yarns. Since the stitch yarns are metal, the material being filtered must escape the fibrous bat 2. If the stitch yarns produced an effectively continuous yarn face as claimed in Applicants' invention, then the filtered material is not able to escape the allegedly effectively continuous face. Therefore, the stitch yarns in Lefkowitz cannot be effectively continuous. In addition, Kyle and Taylor also fail to disclose the stitch bonded yarn face of the present invention insofar as neither reference teaches, suggests, or implies providing a yarn face that is effectively continuous so that the felt web is not generally exposed.

12. Also, in rejecting the current claims, Examiner up to this point has relied heavily on her own definition of Applicants' "felt web," such definition being "any nonwoven, web, or batting comprising discontinuous or staple fibers." In my expert opinion, Examiner has

² The identified figures in Sternlieb and Lefkowitz are considered to accurately portray those respective inventions in contrast to Figs. 3 and 4 of the present case which are "greatly exaggerated" as expressly stated in the specification.

improperly defined Applicants' "felt web" and has provided a grossly, overly broad interpretation. The use of "web," in "felt web," in Stern is clearly understood to mean simply "a layer or sheet" such that a "felt web" is a felt layer, i.e. a layer of felt. Concerning "felt," this is a well known term of art in the textile industry and, as of the time of the invention, is understood to mean a nonwoven sheet of matted material of wool, hair, fur, or manufactured fibers (e.g. polyester, polypropylene, or rayon) made by a combination of mechanical and chemical action, pressure, moisture, and heat, such matted material has structural integrity, i.e. tensile strength, in all directions. Due to the well understood meaning of felt in the textile industry, it is a simple exercise for one skilled in the art to recognize textiles that, in fact, are not felt webs. Accordingly, for purposes of differentiating the references cited against Applicant by Examiner in the August 5, 2005, I have conducted this exercise below.

13. Generally, Sternlieb, Lefkowitz, Ott, and Gillies individually, or in combination, fail to disclose a stitch bonded fabric which includes a felt. More specifically, Sternlieb discloses a dimensionally stable fabric including a layer of carded fibers reinforced by a woven fabric layer, said layer of carded fiber being unbonded, uncompacted, and unmatted and of intermingled, non-parallel fibers. To one skilled in the art, these layers of unmatted carded fibers and of woven fabric are not felts. Lefkowitz discloses a stitch knitted filter for high temperature fluids including a batt of relatively brittle fibers. To one skilled in the art, a batt of relatively brittle, unmatted fibers is not a felt. Ott discloses a stitch bonded composite wiper including a middle layer of cellulose natural fibers and outer layers of layers of either continuous filament thermoplastic fibers, meltblown thermoplastic microfibers or rayon fibers, such

unmatted inner and outer layers are not felt to one skilled in the art. Finally, Gilles discloses a reusable diaper including a median layer of carded and crosslaid viscose rayon fibers having a cross-section of substantially rigid multi-limbed configuration, this media layer is stitch bonded. To one skilled in the art, this median layer of carded and crosslaid viscose rayon fibers is not matted and, thus, not a felt.

14. Accordingly, none of Examiner's cited art discloses the combination of Applicants' stitch bonded yarn faces and felt, or felt web. And, while Ott and Gilles appear to disclose stitch bonded yarn faces and Kyle and Taylor appear to disclose a felt, or felt web, there simply is no motivation for one skilled in the art to modify or combine any of these references to arrive at Applicants' stitch bonded fabric, as is further explained next.

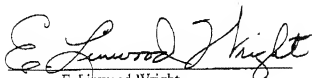
15. Kyle appears to provide an assembly for the management of incontinence which includes a layer of non-absorbent hydrophobic textile material, identified as a needled felt, through which urine can freely pass and a layer of absorbent hydrophilic textile material, such as a non-woven felted fabric, behind the non-absorbent layer to receive and absorb urine passing through the non-absorbent layer. These layers may be sewn, bonded, quilted or welded together. Advantageously, the assembly of Kyle purportedly provides absorbent properties superior to conventional paper incontinence pads. However, noticeably lacking from Kyle's assembly is Applicant's yarn face for providing patient comfort. In fact, there simply is no teaching, suggestion, or implication in Kyle motivating one of skill in the art to provide the assembly with an effectively continuous stitch bonded yarn face as Kyle clearly concerns itself with providing only a better absorbing incontinent pad. And, even assuming *arguendo* that one would consider the possibility that stitch bonding may be used to integrate the two layers of material in Kyle, there still lacks any motivation whatsoever to provide Kyle's incontinent pad with the specific

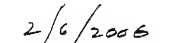
type of stitch bonded yarn faces, i.e. the effectively continuous yarn faces, of Ott and/or Gilles. As such, one skilled in the art simply is not motivated to provide Applicants' yarn face of fabric about the felt layer(s) of Kyle. In addition, Taylor, similar to Kyle, provides no teaching, suggestion, or implication to provide a yarn face, like Applicants, on its liquid absorbing pad. In fact, it would require destruction, i.e. complete removal, of the outer layer(s) of non-absorbent textile material of the pad so that the inner layer of nonwoven fibrous mat could be stitch bonded.

16. Furthermore, it should be emphasized that Gilles' stitch bonded median layer, as already discussed above, is incorporated between outer layers 12 and 16, thereby effectively hiding within the diaper any yarn face presented on the surface of the median layer. In stark contrast, Applicants' stitch bonded fabric includes a stitch bonded yarn face on the outside of the product to provide a soft, comfortable surface for a patient. Clearly, it is nonsensical, certainly to one skilled in the art, to combine Gilles' stitch bonded median layer with any reference, let alone Kyle, to provide Applicants' stitch bonded fabric having a yarn face that is situated on the outside of the product. Specifically concerning Ott, one skilled in the art also is not motivated to combine the wiper product of Ott with an incontinent pad, such as is disclosed in Kyle, in an effort to arrive at Applicants' fabric face product. Finally, it is noted that neither Ott nor Gilles teach, suggest, or imply replacing their stitch bonded fabrics with a felt insofar as each of the non-felt fabrics of Gilles and Ott are purposefully selected to obtain desired outcomes. Accordingly, one skilled in the art is not motivated to modify or combine one or more of Ott, Gilles, Kyle, and Taylor.

17. For all of the above reasons, one skilled in the art would neither look to Sternlieb, Lefkowitz, Ott, Gillies, Taylor nor Kyle, alone or in any combination, to arrive at Applicants' claimed invention, i.e. a stitch bonded fabric.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-referenced patent application as originally filed and/or any patents to be issued and/or granted thereon.


E. Linwood Wright


Date

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Phone: 434-836-2511 (home)
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Current status: Retired, and working under contract for Dan River Inc. as a consultant

Most recent employer: Dan River Inc., Danville, VA

Most recent position: Vice-president, Quality and Development

Years with Dan River: 49

Job placements over years (all at Dan River Inc.):

1956-1960-Research Chemist
1960-1971-Group Leader, Applied Finishing Research
1971-1975-Director of Technical Services
1975-1979-Director of Research
1979-1984-Vice-President, Research and Development
1984-1986-President, Dan River Service Corporation
1986-1988-Vice-President, Research and Development
1988-2004-Vice-President, Quality and Development

Education: Bachelor of Science, Chemistry-Duke University
Master of Science, Physical Chemistry-Duke University
The Executive Program, Darden Graduate School of Business, University of Virginia

Professional Affiliations: Current Chairman, Home Textiles Committee, National Textile Association
Senior member, American Society for Quality
Senior member, American Association of Textile Chemists and Colorists
Past Chairman, Bed & Bath Sub-committee, American Textile Manufacturers Institute
Past Chairman, Consumer Affairs Committee, American Textile Manufacturers Institute
Past vice-chairman, Executive Committee for Research, American Association of Textile Chemists and Colorists
Instructor, N C State University, College of Textiles, Extension Department

Civic activities: Member, Council, City of Danville, VA, 1986-1998
Vice-mayor, City of Danville, VA, 1990-1996
Mayor, City of Danville, VA, 1996-1998

Past president, Kiwanis Club of Danville, VA
Past president, Danville Museum of Fine Arts and History
Past president, Danville Concert Association
Past chairman, Virginia Philpott Manufacturing Extension
Partnership
Past president, Danville Area Association for the Arts and
Humanities
Member, Danville Development Council
Past chairman, Danville Development Council
Vice-chairman, Danville Regional Health Foundation
President, Future of the Piedmont Foundation
Chairman, Board of Trustees, Institute for Advanced
Learning and Research

PATENT

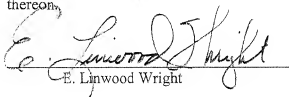
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/558,329
Filed: April 25, 2000
Art Unit: 1711
Examiner: Cheryl Juska
Applicant: Stern et al.
Title: Stitch Bonded Fabric and Fluid-Retaining Fabric Made Therewith
Atty Docket: STAN-09RE
Conf. No.: 9722

SUPPLEMENTAL DECLARATION OF E. LINWOOD WRIGHT
PURSUANT TO 37 C.F.R. § 1.132

I, E. Linwood Wright, previously provided my declaration that I understand was submitted with Applicant's Amendment filed February 6, 2006 in response to the Office Action mailed August 5, 2005. To complete the record, I further declare that (a) I was compensated at the rate of \$100 per hour for my work related to my aforesaid declaration, and (b) I also prepared a declaration for the same assignee submitted in U.S. Application No. 10/251,163 (for which I was also compensated at the same hourly rate).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-referenced patent application as originally filed and/or any patents to be issued and/or granted thereon.


E. Linwood Wright

2/23/2006
Date



RELATED PROCEEDINGS APPENDIX

Decision on Appeal mailed January 19, 2005 (Appeal No. 2005-0019).

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

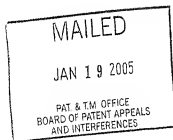
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDOLPH A. STERN
and
MICHAEL N. BYLES

Appeal No. 2005-0019
Reissue Application No. 09/558,329¹

ON BRIEF



Before KRATZ, TIMM, and POTEATE, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This reissue application comes before us after a previous remand (Remand mailed December 18, 2002). In response to the remand, the Examiner reopened prosecution (Office Action mailed June 3, 2003), after which, Appellants requested reinstatement of the appeal (Supplemental Appeal Brief mailed October 6, 2003).

This reinstated appeal involves claims 1-87, which are all of the claims pending in this reissue application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

¹Application for Reissue of U.S. Patent 5,902,757.



The Supplemental Appeal Brief does not address all the issues on appeal but, instead, incorporates by reference the prior briefs (Supp. Brief, p. 3, n.1). We, therefore, decide the reinstated appeal based on the issues and arguments presented to us in the Brief filed November 29, 2001 (Brief), Reply Brief filed April 12, 2002 (Reply Brief), Supplemental Brief filed October 6, 2003 (Supp. Brief), Answer mailed March 15, 2004, and the Reply Brief filed May 14, 2004 (Supp. Reply Brief).

INTRODUCTION

The claims on appeal are directed to a stitch bonded facing fabric and fluid retaining fabrics, such as incontinent pads, which include the stitch bonded fabric therein. Of the claims directed to the stitch bonded fabric, claim 1 illustrates the original patented invention while claims 30 and 65 illustrate the broadened subject matter sought in the reissue:²

1. A stitch bonded facing fabric comprising:

a first layer of hydrophobic felt;

a second layer of hydrophilic felt being adjacent to the first layer so as to define a felt web having an upper surface defined by an upper side of the first layer and a lower surface defined by a lower side of the second layer; and

a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn

²The bulk of the issues on appeal can be resolved by considering the issues as represented by claims 1, 30, and 65. There is, therefore, no reason to discuss, here, the details of the claims directed to fluid retaining fabrics and incontinent pads.

segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface.

30. A stitch bonded facing fabric comprising:

a felt web having an upper surface and a lower surface; and

a plurality of stitch bonding yarns repeatedly extending though the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segment extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface.

65. A stitch bonded facing fabric comprising:

a first layer of felt having hydrophilic properties and further having an outer surface; and

a plurality of stitch bonding yarns repeatedly extending though the first layer of felt with yarn segments extending across the outer surface of the layer of felt, such that the yarn segments extending across the felt layer outer surface cooperate to form a yarn face above the felt layer outer surface.

The Examiner maintains various grounds of rejection including rejections under 35

U.S.C. § 112, ¶ 1, § 102(b), and § 103(a). To support the rejections based on anticipation and obviousness, the Examiner relies upon the following prior art references:

Sternlieb	4,026,129	May 31, 1977
Kyle et al. (Kyle)	4,128,686	Dec. 5, 1978
Lefkowitz et al. (Lefkowitz)	4,181,514	Jan. 1, 1980
Ott	4,675,226	Jun. 23, 1987
Gillies et al. (Gillies)	5,356,402	Oct. 18, 1994
Taylor	EP 0 261 904	Mar. 30, 1988

The specific rejections maintained are as follows:

1. Claims 30-87 stand rejected under 35 U.S.C. § 112, ¶ 1 as based on a disclosure which is not enabling.
2. Claims 65, 67-69 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sternlieb.
3. Claims 30-37 and 51-64 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lefkowitz.
4. Claims 1, 3-9, 12, 14-20, 30, 32-38, 51, 53-56, 58, 59, 61-66, 68, and 69 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ott.
5. Claims 30, 32-36, 39, 41, 42, 46-51, 53-56, 65, 68, 69, 80, 83, 84, 86, and 87 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gillies.
6. Claims 2, 10, 11, 13, 21, 22, 31, 52, 57, 60, and 67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ott.³
7. Claims 1, 3-9, 12, 14-20, 23, 26-29, 37, 38, 43, 58, 61-64, 66, 70, 71, 73, 74, 76-79, and 81 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillies in view of Ott.
8. Claims 10, 11, 21, 22, and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillies in view of Ott.

³For claims 2, 13, 31, 52, 60, and 67, the Examiner takes Official Notice of certain facts.

9. Claims 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillies in view of Ott, Lefkowitz and Kyle.
10. Claims 40 and 82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillies in view of Taylor.
11. Claims 31, 44, 45, 52, 67, and 85 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillies in view of Sternlieb.
12. Claims 1-23, 25-39, 41-71, 73-81, and 83-87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kyle in view of Gillies, Ott, and/or Sternlieb.
13. Claims 24, 40, 72, and 82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kyle in view of Gillies, Ott, and/or Sternlieb and further in view of Taylor.

We reverse with respect to the rejection under 35 U.S.C. § 112, ¶ 1, but we affirm with respect to the rejections under 35 U.S.C. §§ 102(b) and 103(a). Our reasons follow.

OPINION

The Enablement Rejection

The Examiner has rejected claims 30-87 under 35 U.S.C. § 112, ¶ 1 as based on a disclosure which is not enabling (Answer, p. 3). According to the Examiner, "[t]he dual layer of hydrophobic/hydrophilic felt web critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure." (Answer, p. 3). The Examiner cites *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976) in support of the rejection.

"The first paragraph of 35 U.S.C. § 112 requires that the specification of a patent must enable a person skilled in the art to make and use the claimed invention." *In re Wands*, 858 F.2d 731, 735, 8 USPQ2d 1400, 1402 (Fed. Cir. 1988). Although not explicitly stated in § 112, to be enabling, the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

The purpose of the enablement requirement is to "ensure[] that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims." *Crown Operations Int'l. Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1378-79, 62 USPQ2d 1917, 1924 (Fed. Cir. 2002)(quoting *Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys.*, 166 F.3d 1190, 1196, 49 USPQ2d 1671, 1675 (Fed. Cir. 1999)). Because the inventor is speaking to those of ordinary skill in the art, he or she may begin the discussion at the point at which his or her invention begins. In other words, the inventor need not include in the specification that which is already known and available to one of ordinary skill in the art. *See In re Howarth*, 654 F.2d 103, 105, 210 USPQ 689, 691-92 (CCPA 1981) ("An inventor need not, however, explain every detail since he is speaking to those skilled in the art."). Nor must the inventor necessarily describe how to make and use every possible variant of the claimed invention, for the artisan's knowledge of the prior art and routine experimentation can often fill gaps, provide a basis for interpolation between embodiments, and perhaps even provide a basis for extrapolation beyond the disclosed embodiments, depending upon the predictability of the art.

AK Steel v. Sollac, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003); *see also Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by some experimentation such as routine screening."). The question, here, therefore, is whether, with the patent specification as an initial guide, the hypothetical skilled artisan's knowledge of the surrounding art and ability to modestly experiment would have been sufficient to enable him to make and use a stitch bonded facing fabric using a felt web without the dual layer hydrophobic/hydrophilic structure the Examiner states is critical or essential to the practice of the invention.

Unlike the case of *In re Mayhew*, here, the specification does not clearly indicate that the dual layer hydrophobic/hydrophilic felt layer configuration is essential or critical in the practice of the invention, i.e., in a stitch bonded fabric, fluid retaining fabric, and incontinent pad. Particularly, it is noted that, in the Description of the Prior Art, the specification indicates that a typical incontinent pad has a knit or woven facing fabric layer to which is quilted a felt layer. The felt layer is included to provide rigidity to the pad (Patent specification, col. 1, ll. 18-21). The specification then goes on to state that the prior art facing fabric sold under the trademark Comply® is "highly desirable" in incontinent pads because its hydrophobic/hydrophilic dual layer construction wicks away fluids from the face of the fabric (col. 1, ll. 25-35). That the dual layer configuration is highly desirable does not make it essential or critical to the invention. This is especially the case with regard to the claims directed to a stitch bonded fabric rather than the

incontinent pad. Note that in *Mayhew*, the claimed zinc process was wholly inoperative without the step of cooling which was deemed essential to the process.

We are cognizant of the fact that the Summary of the Invention section of Appellants' patent specification characterizes the invention as a fabric including "a felt web having a hydrophobic upper aspect and a hydrophilic lower aspect" and that the only embodiments of the fabric pictured in the Drawings and discussed in the Detailed Description of the Drawings include such hydrophobic/hydrophilic dual layers. In some circumstances, such a narrow characterization of the invention might suffice to show a lack of enablement, but, here, as we discussed above, there is further evidence indicating that fluid retaining fabrics had been made by those of ordinary skill in the art without dual layer fabrics, the felt being used to provide rigidity to the pad.

We are also cognizant of the fact that the dual layer configuration is taught in the specification as being desirable for providing wicking. But wicking is merely taught in the specification as desirable, not as a requirement. Nor do the claims require any particular level of wicking, particularly the claims directed to the stitch bonded facing fabric itself. Thus, the claims need not be enabling for any particular level of wicking.

The Examiner is also concerned that the claims encompass inoperable embodiments (Answer, p. 4-5). But the claims need not exclude inoperative embodiments. What the Examiner must demonstrate is that the number of inoperative combinations is so significant that one of ordinary skill in the art is forced to experiment unduly in order to practice the claimed

invention. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576-77, 224 USPQ 409, 414 (Fed. Cir. 1984); *In re Cook*, 439 F.2d 730, 735, 169 USPQ 298, 302 (CCPA 1971). That, however, has not been shown to be the case here.

The specification need not explicitly teach those in the art to make and use the invention; the requirement is satisfied if, given what they already know, the specification teaches those in the art enough that they can make and use the invention without "undue experimentation." *Amgen v. Hoechst Marion Roussel*, 314 F.3d 1313, 1334, 65 USPQ2d 1385, 1400 (Fed. Cir. 2003). The enablement question presented to us here is a legally challenging and close question. However, given that the specification does not clearly indicate that facing fabrics absolutely must contain the dual layers to be functional we ultimately conclude that the evidence is insufficient to support a rejection under 35 U.S.C. § 112, ¶ 1.

Interpretation of "Yarn Face"

Appellants make one overarching argument relevant to each of the rejections over prior art: That the Examiner has failed to properly interpret the phrase "yarn face," a phrase used in each of the claims on appeal, and that no yarn face is shown, disclosed or otherwise suggested in the prior art (Brief, pp.14-15; Reply Brief, pp. 7-10; Supp. Brief, pp. 15 and 18-19; Supp. Reply Brief, pp. 3-7).

Appellants interpret the disputed phrase more narrowly than the Examiner. According to the Appellants, "yarn face" is defined in the specification as having very closely spaced or densely packed yarn segments, so dense, in fact, that the "yarn face" is effectively continuous

such that the felt is not generally exposed (Brief, pp. 14-15 referring to patent specification, col. 2, ll. 52-65). The Examiner, on the other hand, concludes that the claims are not so narrow. According to the Examiner, "[n]one of the claims state that the yarn faces must be 'continuous' or even 'effectively continuous.'" (Answer, pp. 25-26).

The main question before us, then, is one of claim interpretation and, specifically, whether the Examiner's interpretation of "yarn face" is reasonable. See *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1028-29 (Fed. Cir. 1997). We conclude that the Examiner's interpretation is reasonable in light of the evidence. First, we find no definition of "yarn face" in the patent specification at column 2, lines 52-65 or any other portion of the specification as argued by Appellants (Brief, pp. 14-15; Reply Brief, pp. 7-8; Supp. Reply Brief, p. 4). What we do find is a discussion stating that the faces 24 and 26 "are effectively continuous such that web 12 is not exposed thereat, although small gaps or interstices (as at 28) between adjacent yarn segments 18' or 18" may allow viewing of felt surface 20 or 22 upon close inspection." (Patent specification, col. 2, ll. 59-63). That is not a definition, but a further description of the invention and a non-claimed aspect of the invention at that. The more telling description in the patent specification indicates that:

yarn segments 18' and 18" do not become embedded into the web 12 below surfaces 20 and 22 thereof, but rather extend across the surfaces 20 and 22, and are of sufficient density that yarn segments 18' cooperate to define a top yarn face 24 of fabric 10 above the web upper surface 20 and yarn segments 18" cooperate to define a bottom yarn face 26 of fabric 10 below web lower surface 22 [col. 2, ll. 52-59].

This usage of the word “face” in the specification comports with the ordinary meaning of “face” as a front, upper, or outer surface.⁴ Therefore, while the “yarn face” must have a density of yarn which is sufficient to define a front, upper, or outer surface, it need not be “effectively continuous” as further described in the specification.

Our reviewing court has counseled the PTO to avoid the temptation to limit broad claim terms solely on the basis of specification passages and tells us that, absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition. *In re Bigio*, 381 F.3d 1320, 1324-25, 72 USPQ2d 1209, 1210-11 (Fed. Cir. 2004). Here, there is no express disclaimer of the reasonable broader definition. We, therefore, decline to limit “yarn face” to the narrower definition espoused by Appellants.

We conclude that the Examiner has correctly interpreted the phrase “yarn face” and has correctly refrained from reading extraneous limitations from the specification into the claims.

Anticipation by Ott

Claims 1, 3-9, 12, 14-20, 30, 32-38, 51, 53-56, 58, 59, 61-66, 68, and 69 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ott. None of the claims are argued separately. We select claim 30 to represent the issues on appeal. Claim 30 is directed to a facing fabric with a felt web and stitch bonded yarns forming top and bottom yarn faces.

⁴See definition 5 for face, Merriam-Webster Dictionary, electronic ed., version 2.0 (2000). A copy accompanies our decision.

Appellants argue that the stitch density for the wiper disclosed by Ott is very low and is not consistent with a yarn face according to Appellants' claimed invention (Brief, p. 18). In support, Appellants cite to column 3, lines 31-34 of Ott which states that "[t]he preferred stitch used in this invention has a length of 3 millimeters and is spaced in the cross web direction at 14 stitch lines per inch or 14 guage [sic]."

The argument is not convincing. The portion of Ott cited by Appellants indicates that the space between the stitch lines is less than 1/14th of an inch. It is reasonable to conclude that the stitch bonding of 140-160 denier polyester stitching yarn in 3 mm stitches at 14 stitch lines per inch using a Maliwatt stitching machine would result in a surface that would appear to the eye to be a textile surface or "yarn face" as claimed. Moreover, Ott states that the stitch bonded product described therein is extremely cloth-like owing to the nature of the material layers having been bonded together by a textile method of stitching (Ott, col. 2, ll. 37-39) and describes the product as having a stitched laminate surface 72 (col. 3, ll. 62; *see also* Fig. 2 at 72). The evidence supports the finding that Ott describes a "yarn face."

We find that there is a sufficient level of evidence to support the anticipation rejection maintained by the Examiner. Appellants have failed to rebut this evidence.

Anticipation by Lefkowitz and Gillies

Claims 30-37 and 51-64 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lefkowitz. Claims 30, 32-36, 39, 41, 42, 46-51, 53-56, 65, 68, 69, 80, 83, 84, 86, and 87 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gillies. None of the claims are argued

separately. We select claim 30 to represent the issues on appeal for each of the rejections. While we have reviewed the rejections separately, we will address them together as the issues are sufficiently the same for each.

With regard to each of these rejections, Appellants argue that there is no "yarn face" described in any of the applied references (Brief, pp. 19). We agree with the Examiner that each of the references describes stitch bonded fabrics with the required yarn faces (Answer, pp. 5-7). Each reference describes a stitch bonded felt layer. In each case, the gauge of the stitching is sufficiently dense to form a "face" as claimed. For instance, Example 1 of Lefkowitz describes a felt stitch bonded with yarn of 5 mil diameter in a tricot stitch with a machine gauge of 40 needles per 10 centimeters or 10 chain stitches per inch. Gillies describes a density of 2 to 10 rows per inch with a preference for 5 rows per inch of 150 denier polyester thread (Gillies, col. 5, 23-36). What would appear to the eye in each case is a textile surface or "yarn face" as claimed.

We find that there is a sufficient level of evidence to support the anticipation rejections maintained by the Examiner. Appellants have failed to rebut this evidence.

Anticipation by Sternlieb

Claims 65, and 67-69 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sternlieb. The claims are not argued separately, therefore, we select claim 65 to represent the issues on appeal.

Claim 65 requires a yarn face on one side of a felt layer. Appellants argue that "Sternlieb fails to teach, disclose or otherwise suggest any yarn face as recited in Appellants' claims." (Brief, p. 16).

We agree with the Examiner that the stitch knitted yarns on the lower surface of the scrim 9 of Sternlieb cooperate to form a "yarn face" as required by claim 65 (Answer, p. 5). The stitches are configured to sit on the surface of the scrim and are of such size, configuration, and density that they are the portions that touch any wearing surface, thus, protecting the underlying structure from abrasion (Sternlieb, col. 3, ll. 3-9). There are 12 stitches per inch of 2 ounce per yard configured in a zig-zag pattern overlying the scrim (Sternlieb, col. 2, l. 57 to col. 3, l. 2, and col. 3, ll. 28-31). The evidence is sufficient to support the Examiner's finding of a density sufficient to form a surface representing a "face" of yarn as claimed.

Obviousness

Appellants advance several additional arguments with regard to the rejections under 35 U.S.C. § 103(a). For instance, Appellants argue that claims 1-29 were allowed in the original patent over the same art now being applied by the Examiner in this reissue proceeding (Brief, p. 20). But claims in a reissue application enjoy no presumption of validity. *In re Sneed*, 710 F.2d 1544, 1550 n.4, 218 USPQ 385, 389 n.4 (Fed. Cir. 1983). As stated in 37 CFR § 1.176 (2000), "[a] reissue application will be examined in the same manner as a non-reissue, non-provisional application." Whether the Examiner has taken a position contrary to the position of the original examiner is immaterial.

Appellants further argue that the Examiner's motivation for modifying the teaching of Gillies so as to replace two steps of stitch bonding with one step of stitch bonding to eliminate a step is not persuasive (Brief, pp. 20-21). We are unconvinced by the argument for the reasons provided by the Examiner in the Answer at pages 28-29. The motivation flows from the teachings and suggestions provided in the relied upon references.

Appellants argue that, with regard to the rejections including Kyle, the Examiner has overlooked that, while Appellants' invention produces a product with its own "yarn face," the Kyle product requires an "upper sheet 25" or "protective sheet 41" in order to provide a comfortable facing fabric (Brief, p. 21). Appellants state that their invention eliminates the need for such separate sheets (*Id.*).

We find no reversible error by the Examiner with regard to the rejections relying upon Kyle (Answer, pp. 11-13). Kyle describes an incontinence pad with a hydrophobic layer and a hydrophilic layer. As found by the Examiner, Kyle indicates that "[t]he two layers 'can be sewn, bonded, quilted or welded' to each other (col. 4, lines 65-66)." (Answer, p. 12). Gillies, Ott, and Sternlieb, as found by the Examiner, all provide evidence that stitch bonding was a well-known method of bonding by sewing layers of nonwoven webs together (Answer, p. 12). We also note that Ott further indicates that it was known in the art to use stitch bonding to create a textile-like surface on a dual layer felt web. We agree with the Examiner that it would have been obvious to one of ordinary skill in the art to stitch bond the hydrophobic and hydrophilic layers of Kyle together as an alternative method of attachment. The secondary references indicate that there are

benefits to using stitch bonding such as lower cost while maintaining a textile-like feel, durability and cohesive strength (*see e.g.*, Ott, col. 2, ll. 37-45; Gillies, col. 5, ll. 7-11 and 23-27).

Additionally, Appellants challenge the Examiner's use of Official Notice in combination with Ott in rejecting claims 2, 13, 31, 52, 60, and 67 (Supp. Brief, p. 17). The Examiner states in the rejection that Official Notice is taken of the fact that "it is common and well known in the art to employ scrims to reinforce nonwoven materials." In response to the Appellants' demand for evidence, the Examiner directs Appellants' attention to Sternlieb and Lefkowitz which both describe the use of a reinforcing scrim in a stitch bonded product (Answer, p. 30). Appellants do not challenge the Examiner's evidence in the Supplemental Reply Brief. Moreover, we note that Kyle describes the use of a scrim as well (Kyle, col. 3, ll. 18-23 and col. 8, l. 37; scrim 33 shown in Fig. 5). There is ample evidence supporting the finding of the Examiner.

As a final point, we note that Appellants base no arguments upon objective evidence of non-obviousness such as unexpected results. We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 1-87 which has not been sufficiently rebutted by Appellants.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 30-87 under 35 U.S.C. § 112, ¶ 1 is reversed, but the decision to reject claims 1, 3-9, 12, 14-20, 30-39, 41, 42, 46-69, 80, 83, 84, 86, and 87 under 35 U.S.C. § 102(b) and claims 1-87 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


PETER F. KRATZ
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge


LINDA R. POTEATE
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

Appeal No. 2005-0019
Application No. 09/558,329

Page 18

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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDOLPH A. STERN
and
MICHAEL N. BYLES

Appeal No. 2005-0019
Application No. 09/558,329¹

ON BRIEF

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W. HODD. HERRON & EVANS



Before KRATZ, TIMM, and POTEATE, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

RESPONSE TO REQUEST FOR REHEARING

Appellants request rehearing² of our Decision on Appeal dated January 19, 2005. In that Decision we affirmed with regard to the Examiner's rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

In the Brief and Reply Brief, Appellants maintained one overarching argument with respect to all the rejections over prior art. That argument centered on the interpretation of "yarn face" in the

¹Application for Reissue of U.S. Patent 5,902,757.

²Request for Rehearing filed on February 3, 2005.



claims. Each of the claims includes a “yarn face” which overlies a felt layer. Appellants interpreted a “yarn face” as “having very closely spaced or densely packed segments of the stitch bonding yarns so as to be effectively continuous such that the felt web is not generally exposed.” (Brief, p. 15). The Examiner determined that the claims are not limited to “continuous” or “effectively continuous” yarn faces (Answer, pp. 25-26). In our Decision, we concluded that the Examiner’s interpretation was reasonable (Decision, pp. 10-11).

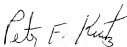
Appellants do not argue that we erred in our Decision, rather, they solicit from us a new decision, or an amended decision, with an express statement as to whether a claim amendment reciting “effectively continuous yarn face” would overcome the specific prior art rejections. As pointed out by Appellants (Request, p. 3), we have the authority to make such a statement under 37 CFR § 41.50(c)(eff. September 13, 2004). We declined to execute that authority at the time of our Decision and we continue to decline to execute that authority now.

To the extent that Appellants continue to argue that their claims are limited to articles with “effectively continuous yarn faces” we remain unconvinced for the reasons provided in our Decision. Moreover, even if we had determined that the claims were so limited, we could not agree that all of the rejections would be overcome, particularly in view of the teachings of Ott.

The subject request has been granted to the extent that our decision has been reconsidered, but is denied with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

REHEARING DENIED



PETER F. KRATZ
Administrative Patent Judge



CATHERINE TIMM
Administrative Patent Judge



LINDA R. POTEATE
Administrative Patent Judge

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Appeal No. 2005-0019
Application No. 09/558,329

Page 4

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Randolph A. Stern and Michael N. Byles

Reissue 09/558,329
Patent 5,902,757
Technology Center 1700

Mailed: March 17, 2009

Before *Lynn M. Kryza, Deputy Chief Trial Administrator.*

ORDER RETURNING UNDOCKETED APPEAL

This reissue application was electronically received by the Board of Patent Appeals and Interferences on **January 12, 2009**. A review of the reissue application revealed that it is not ready for docketing as an appeal. Accordingly, the reissue application is herewith being returned to the



Examiner to address the following matter(s) requiring attention prior to docketing.

The amendments are not in compliance with 37 C.F.R. § 1.173. All amendments to the original patent claims should show any additions with underlining and deletions with bracketing, with respect to the original patent text. No strikeout is permitted in a reissue application. The Claim Appendix should also include all markings pursuant to 37 C.F.R. § 1.173.

The amendments dated May 03, 2005, and February 06, 2006, do not appear to have been accompanied by a supplemental reissue declaration. Whenever claims are amended or added, a supplemental reissue declaration is required pursuant to MPEP 1414.01. Form PTO/SB/51S, "Supplemental Declaration For Reissue Patent Application To Correct 'Errors' Statement ([see] 37 C.F.R. § 1.175(b)(1)), " may be used to prepare a supplemental reissue declaration. Form PTO/SB/51S serves to indicate that every error in the patent that was corrected in the reissue application, but was not covered by a prior reissue oath/declaration submitted in the reissue application, arose without any deceptive intention on the part of the applicant.

Although a declaration was filed with the Request for Continued Examination (RCE) of May 03, 2005, it does not appear to be signed by all of the inventors, and it does not appear to be a proper reissue declaration. In a broadening reissue application, all supplemental reissue declarations must be signed by all inventors. See MPEP 1414.01(III). 37 C.F.R. § 1.175(b)(1) taken in conjunction with Section 1.172, requires a supplemental reissue declaration be signed by all of the inventors.

It does not appear that the Examiner has included in an Office action the appropriate rejection of all the reissue claims under 35 U.S.C. 251, as

being based upon a defective reissue declaration, and the requirement of a supplemental reissue declaration signed by all of the inventors to overcome such rejection.

CONCLUSION

Accordingly, it is

ORDERED that the above identified Reissue application be returned to the Examiner for

- 1.) requiring correction of all amended and new claims, to be in compliance with 37 CFR 1.173;
- 2.) requiring a corrected Claim Appendix in compliance with 37 C.F.R. § 1.173;
- 3.) requiring submission of a proper supplemental reissue declaration to overcome the rejection of all the reissue claims under 35 U.S.C. 251, as being based upon a defective reissue declaration ; and
- 4.) for such other action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

LMK/rvb

Reissue 09/558,329
Patent 5,902,757

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